IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Jorg G. Schleicher et al.
Serial No. 09/963,812
Filed: 09/26/2001
For: **METHOD AND SYSTEM FOR GENERATING REVENUE IN A PEER-TO-PEER FILE DELIVERY NETWORK**

Examiner: Fadey S. Jabr
Art Unit: 3628

Mail Stop Appeal Brief – Patents
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

An **APPEAL BRIEF** is filed herewith. The Appellants have not enclosed a payment in the amount of $510.00 to cover the fee associated with this appeal brief as required by 37 C.F.R. § 1.17(c) because the Appellants previous paid for the Appeal Brief filed on December 6, 2006. The Appeal Brief filed on December 6, 2006 was not sent to the Board of Patent Appeals and Interferences and no decision was rendered in response to the Appeal Brief filed on December 6, 2006. The Appellants should not have to pay the full amount of $510.00 for this Appeal Brief because the Appeal Brief filed on December 6, 2006 had been paid for and no decision had been rendered. See M.P.E.P § 1207.04. The Appellants note that the fee for an Appeal Brief increased by $10.00. As such, only a $10.00 fee is due for the current Appeal Brief. The Director is hereby authorized to charge the $10.00 Appeal Brief fee to Deposit Account 50-1732, and to consider this a petition therefor. If any additional fees are required in association with this appeal brief, the Director is also hereby authorized to charge them to Deposit Account 50-1732, and to consider this a petition therefor.

APPEAL BRIEF

(1) REAL PARTY IN INTEREST

The real party in interest is the assignee of record, i.e., Qurio Holdings, Inc. of 1130 Situs Court, Suite 216, Raleigh, NC 27606.

(2) RELATED APPEALS AND INTERFERENCES

This Appeal Brief is related to a Notice of Appeal filed on July 7, 2006, and an Appeal Brief filed on December 6, 2006. In response to the Appeal Brief filed on December 6, 2006, an

Examiner's Answer was mailed on February 27, 2007. The Appellants filed a Reply Brief on April 24, 2007. The Appeal Brief filed on December 6, 2006 was undockected and returned to the Examiner for clarification of the claims status on October 5, 2007. A Revised Examiner's Answer was mailed on October 30, 2007 to which the Appellants filed a response on December 27, 2007. Prosecution was then reopened through the mailing of a Final Office Action on February 4, 2008. The Appellants filed a response to the Final Office Action on April 3, 2008. The Examiner responded with an Advisory Action mailed April 29, 2008. In response to the Advisory Action, the Appellants filed a new Notice of Appeal on May 13, 2008. This Appeal Brief is filed in response to the Final Office Action mailed February 4, 2008 and the Advisory Action mailed April 29, 2008.

(3) STATUS OF CLAIMS

Claims 1-29 were rejected with the rejection made final on February 4, 2008.

Claims 1-29 are pending and are the subject of this appeal.

(4) STATUS OF AMENDMENTS

All amendments have been entered to the best of the Appellants' knowledge. No amendments have been filed after the Final Office Action mailed February 4, 2008.

(5) SUMMARY OF CLAIMED SUBJECT MATTER

In the following summary, the Appellants have noted where in the Specification certain subject matter exists. The Appellants wish to point out that these citations are for demonstrative purposes only and that the Specification may include additional discussion of the various elements, citations to which are not pointed out below. Thus, the noted citations are in no way intended to limit the scope of the pending claims.

The present invention provides a method and system for generating revenue in a peer-to-peer file delivery network. The method and system include enabling peer-to-peer file sharing of content by initiating, on one client node, a download of a particular content item served from the server node or another client node, and then charging a fee based on a quantity of the content served (Specification, p. 4, lines 19-23). The method and system further include enabling decentralized downloads of subscription-based content. The decentralized downloads are

provided by allowing the client nodes to subscribe to one or more of the subscription-based content, periodically sending the subscribed to subscription-based content to each the respective subscribing client nodes, and then charging a fee to providers of the subscription-based content for serving the subscription-based content (Specification, p. 5, lines 1-6).

Another aspect of the present invention includes providing direct marketing wherein users on the network are targeted with direct marketing material and providers of the marketing content are charged for the service (Specification, p. 5, lines 8-10). A further aspect of the present invention includes enabling client nodes to become affiliate servers nodes that deliver content to other client nodes, thus taking advantage of idle bandwidth (Specification, p. 5, lines 10-13). As an incentive, the owners of the affiliate servers may be paid a percentage of the fee charged for serving the files to the other client nodes (Specification, p. 5, lines 13-14).

In particular, independent claim 1 recites a method for generating revenue in a peer-to-peer file delivery network (such as network 10, Figure 1A), the peer-to-peer file delivery network including at least one server node (such as server node 12, Figure 1A; see also Figure 1B) and multiple client nodes (such as client nodes 14, Figure 1A), the method comprising the steps of:

(a) enabling peer-to-peer file sharing of content (Specification, p. 9, lines 1-2; see also Figure 2, step 42) by,

(i) initiating on one client node a download of a particular content item served from the server node or another client node (Specification, p. 4, lines 20-22, and p. 9, lines 3-7), and

(ii) charging a fee based on a quantity of content served related to the particular content item (Specification, p. 4, lines 22-23, p. 9, lines 2-3 and 9-11, p. 16, lines 7-12, and p. 20, lines 17-18; see also Figure 2, step 44, and Figure 3D, step 152); and

(b) enabling decentralized downloads of subscription-based content (Specification, p. 5, line 1, and p. 9, lines 14-15; see also Figure 2, step 46) by

(i) allowing client nodes of the multiple client nodes to subscribe to the subscription-based content (Specification, p. 5, lines 2-3, and p. 9, lines 16-17; see also Figure 3A, steps 100 and 102)

i) periodically sending the subscription-based content to each respective subscribing client node (Specification, p. 5, lines 3-5, and p. 9, lines 17-19; see also Figure 3D, steps 140 and 148), and

(iii) charging a fee to providers of the subscription-based content for serving the subscription-based content (Specification, p. 5, lines 5-6, and p. 9, lines 19-20; see also Figure 2, step 48).

Dependent claim 3 recites the method of claim 1 further including the step of:

(d) enabling client nodes to become affiliate servers that deliver content to other client nodes, and paying owners of the affiliate servers a percentage of the fee charged for serving files (Specification, p. 5, lines 10-14; see also Figure 2, steps 54 and 56)..

Independent claim 9 recites a system for generating revenue in a peer-to-peer file delivery network (such as network 10, Figure 1A), the peer-to-peer file delivery network including at least one server node (such as server node 12, Figure 1A; see also Figure 1B) and multiple client nodes (such as client nodes 14, Figure 1A), the system comprising:

means for enabling peer-to-peer file sharing of content (Specification, p. 9, lines 1-2; see also Figure 2, step 42) whereby one client node initiates a download of a particular content item served from the server node or another client node (Specification, p. 4, lines 20-22, and p. 9, lines 3-7), and wherein a fee is charged based on a quantity of content served related to the particular content item (Specification, p. 4, lines 22-23, p. 9, lines 2-3 and 9-11, p. 16, lines 7-12, and p. 20, lines 17-18; see also Figure 2, step 44, and Figure 3D, step 152); and

means for enabling decentralized downloads of subscription-based content that client nodes of the multiple client nodes subscribe to in order to receive periodic updates (Specification, p. 5, lines 1-5, and p. 9, lines 14-19; see also Figure 2, step 46, Figure 3D, steps 140 and 148), wherein a fee is charged to providers of subscription-based content for serving the subscription-based content to the client nodes (Specification, p. 5, lines 5-6, and p. 9, lines 19-20; see also Figure 2, step 48).

The means for enabling peer-to-peer file sharing of content is a client node (such as client node 14 with a client application 22, Figure 1A; see also Specification, p. 8, lines 1-5) and at least one server node (such as server node 12) with at least one database (Specification, p. 11, line 21 through p. 12, line 8; see also Figure 1B). The means for enabling decentralized downloads of subscription-based content is the server node.

Dependent claim 11 recites the system of claim 9 further including means for enabling client nodes to become affiliate servers that deliver content to other client nodes, such that owners of the affiliate servers are paid a percentage of the fee charged for serving files (Specification, p. 5, lines 10-14).

Independent claim 17 recites a computer-readable medium containing program instructions for generating revenue in a peer-to-peer file delivery network (such as network 10, Figure 1A), the peer-to-peer file delivery network including at least one server node (such as server node 12, Figure 1A; see also Figure 1B) and multiple client nodes (such as client nodes 14, Figure 1A), the program instructions for:

(a) enabling peer-to-peer file sharing of content (Specification, p. 9, lines 1-2; see also Figure 2, step 42) by,

(i) initiating on one client node a download of a particular content item served from the server node or another client node (Specification, p. 4, lines 20-22, and p. 9, lines 3-7), and

(ii) charging a fee based on a quantity of content served related to the particular content item (Specification, p. 4, lines 22-23, p. 9, lines 2-3 and 9-11, p. 16, lines 7-12, and p. 20, lines 17-18; see also Figure 2, step 44, and Figure 3D, step 152); and

(b) enabling decentralized downloads of subscription-based content by

(i) allowing client nodes of the multiple client nodes to subscribe to subscription-based content (Specification, p. 5, line 1, and p. 9, lines 14-15; see also Figure 2, step 46),

(ii) periodically sending the subscription-based content to each respective subscribing client node (Specification, p. 5, lines 3-5, and p. 9, lines 17-19; see also Figure 3D, steps 140 and 148), and

(iii) charging a fee to providers of the subscription-based content for serving the subscription-based content (Specification, p. 5, lines 5-6, and p. 9, lines 19-20; see also Figure 2, step 48).

Dependent claim 19 recites the computer-readable medium of claim 17 further including the instruction of:

(d) enabling client nodes to become affiliate servers that deliver content to other client nodes, and paying owners of the affiliate servers a percentage of the fee charged for serving files (Specification, p. 5, lines 10-14; see also Figure 2, steps 54 and 56).

Independent claim 25 recites a method for providing subscription-based decentralized file downloads to client nodes (such as client nodes 14, Figure 1A) in a peer-to-peer public network (such as network 10, Figure 1A), each of the client nodes affiliated with a user account, the method comprising the steps of:

(a) receiving content files (such as files 20a and 20b, Figure 1B) from at least one content provider, the content including free subscription content files, fee-based subscription content files, and marketing content files (Specification, p. 19, lines 1-12);

(b) allowing the client nodes to subscribe to particular content files (Specification, p. 19, lines 1-4; see also Figure 3D, step 140);

(c) periodically delivering the particular content files to respective clients nodes that subscribed to the particular content files (Specification, p. 5, lines 5-6, p. 9, lines 17-19, and p. 20, lines 1-6, see also Figure 3D, step 148);

(d) charging the at least one content provider a fee for delivering the content files to the client nodes over the peer-to-peer public network (Specification, p. 20, lines 17-18; see also Figure 3D, step 152);

(e) charging the at least one content provider a fee for the marketing content files based on a number of users that access the marketing content files once downloaded (Specification, p. 20, lines 18-20; see also Figure 3D, step 154); and

(f) charging user accounts of the client nodes that received fee-based subscription content files (Specification, p. 20, lines 20-21; see also Figure 3D, step 156).

Independent claim 26 recites a method for generating revenue in a peer-to-peer file delivery network (such as network 10, Figure 1A), the network including at least one server node (such as server node 12, Figure 1A; see also Figure 1B) and multiple client nodes (such as client nodes 14, Figure 1A), the method comprising the steps of:

(a) enabling peer-to-peer file sharing of content (Specification, p. 9, lines 1-2; see also Figure 2, step 42) by,

(i) initiating on one client node a download of a particular content item served from the at least one server node or another client node (Specification, p. 4, lines 20-22, and p. 9, lines 3-7), and

(ii) charging a fee based on a quantity of content served related to the particular content item (Specification, p. 4, lines 22-23, p. 9, lines 2-3 and 9-11, p. 16, lines 7-12, and p. 20, lines 17-18; see also Figure 2, step 44, and Figure 3D, step 152);

(b) enabling decentralized downloads of subscription-based content by

(i) allowing client nodes of the multiple client nodes to subscribe to the subscription-based content (Specification, p. 5, line 1, and p. 9, lines 14-15, see also Figure 2, step 46),

(ii) periodically sending the subscription-based content to each respective subscribing client node (Specification, p. 5, lines 3-5, and p. 9, lines 17-19; see also Figure 3D, steps 140 and 148), and

(iii) charging a fee to providers of the subscription-based content for serving the subscription-based content (Specification, p. 5, lines 5-6, and p. 9, lines 19-20; see also Figure 2, step 48);

(c) providing direct marketing (Figure 2, step 50) by

(i) sending marketing content to the client nodes from the at least one server node as well as from other client nodes (Specification, p. 10, lines 12-15), and

(ii) charging a fee to providers of the marketing content (Specification, p. 10, lines 18-19; see also Figure 2, step 52); and

(d) enabling client nodes to become affiliate servers that deliver content to other client nodes, and paying owners of the affiliate servers a percentage of the fee charged for serving files (Specification, p. 5, lines 10-14; see also Figure 2, steps 54 and 56).

Independent claim 27 recites a system for generating revenue in a peer-to-peer file delivery network (such as network 10, Figure 1A), the peer-to-peer file delivery network including at least one server node (such as server node 12, Figure 1A; see also Figure 1B) and multiple client nodes (such as client nodes 14, Figure 1A), the system comprising:

means for enabling peer-to-peer file sharing of content (Specification, p. 9, lines 1-2; see also Figure 2, step 42) whereby one client node initiates a download of a particular content item served from the at least one server node or another client node (Specification, p. 4, lines 20-22, and p. 9, lines 3-7), and wherein a fee is charged based on a quantity of content served related to the particular content item (Specification, p. 4, lines 22-23, p. 9, lines 2-3 and 9-11, p. 16, lines 7-12, and p. 20, lines 17-18; see also Figure 2, step 44, and Figure 3D, step 152);

means for enabling decentralized downloads of subscription-based content that client nodes of the multiple client nodes subscribe to in order to receive periodic updates (Specification, p. 5, line 1-5, p. 9, lines 14-19, see also Figure 2, step 46, and Figure 3D, steps 140 and 148), wherein a fee is charged to providers of the subscription-based content for serving the subscription-based content to the client nodes (Specification, p. 5, lines 5-6, and p. 9, lines 19-20; see also Figure 2, step 48);

means for providing direct marketing to the client nodes such that marketing content is sent to the client nodes from the at least one server node as well as from other client nodes (Specification, p. 10, lines 12-15), and a fee is charged to providers of the marketing content (Specification, p. 10, lines 18-19); and

means for enabling client nodes to become affiliate servers that deliver content to other client nodes, such that owners of the affiliate servers are paid a percentage of the fee charged for serving files (Specification, p. 5, lines 10-14).

The means for enabling peer-to-peer file sharing of content is a client node (such as client node 14 with a client application 22, Figure 1A; see also Specification, p. 8, lines 1-5) and at least one server node (such as server node 12) with at least one database (Specification, p. 11, line 21 through p. 12, line 8; see also Figure 1B). The means for enabling decentralized downloads of subscription-based content is the server node. The means for providing direct marketing is also the server node (Specification, p. 10, lines 12-19; see also Figure 1B). The means for enabling client nodes to become affiliate servers is the client application 22 on the client node 14 (Specification, p. 5, lines 10-14, and p. 8, lines 1-5).

Independent claim 28 recites a system for generating revenue in a peer-to-peer file delivery network (such as network 10, Figure 1A), comprising:

a server node (such as server node 12, Figure 1A; see also Figure 1B) adapted to:

allow a download by a client node (such as any of the client nodes 14, Figure 1A) (Specification, p. 4, lines 20-22, and p. 9, lines 3-7), wherein a fee is charged based on a quantity of content served during the download (Specification, p. 4, lines 22-23, p. 9, lines 2-3 and 9-11, p. 16, lines 7-12, and p. 20, lines 17-18; see also Figure 2, step 44, and Figure 3D, step 152); and

enable downloads of subscription-based content by client nodes (Specification, p. 5, line 1-5, and p. 9, lines 14-19; see also Figure 2, step 46, and Figure 3D, steps 140 and

148), wherein a second fee is charged to providers of the subscription-based content for serving the subscription based content to the client nodes (Specification, p. 5, lines 5-6, and p. 9, lines 19-20; see also Figure 2, step 48).

Independent claim 29 recites a server node (such as server node 12, Figure 1A; see also Figure 1B) comprising:

a network interface; and

a control system adapted to:

share content with a client node (such as any of the client nodes 14, Figure 1A) (Specification, p. 4, lines 20-22, and p. 9, lines 3-7) and charge a fee based on a quantity of content shared with the client node (Specification, p. 4, lines 22-23, p. 9, lines 2-3 and 9-11, p. 16, lines 7-12, and p. 20, lines 17-18; see also Figure 2, step 44, and Figure 3D, step 152);

provide subscription-based content to which the client node may subscribe (Specification, p. 5, line 1-5, and p. 9, lines 14-19; see also Figure 2, step 46, and Figure 3D, steps 140 and 148), wherein a fee is charged to providers of the subscription-based content for providing the subscription-based content to the client node (Specification, p. 5, lines 5-6, and p. 9, lines 19-20; see also Figure 2, step 48); and

provide direct marketing to the client node such that marketing content is provided to the client node and a fee is charged to providers of the marketing content (Specification, p. 10, lines 12-19; see also Figure 2, step 52); and

wherein the client node may become an affiliate server that delivers content to other client nodes such that an owner of the affiliate server is paid a percentage of a fee charged for content delivery (Specification, p. 5, lines 10-14, see also Figure 2, steps 54 and 56).

(6) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. Whether claims 1-6, 9-14, 17-22, and 26-29 were properly rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0062290 A1 to *Ricci* (hereinafter "*Ricci*") in view of U.S. Patent No. 5,819,092 to *Ferguson et al.* (hereinafter "*Ferguson*").

B. Whether claims 7, 8, 15, 16, and 23-25 were properly rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ricci* in view of *Ferguson* and further in view of the Appellants' Related Art (hereinafter "*ARA*").

C. Whether claims 1-27 were properly rejected under the judicially created doctrine of obviousness-type double patenting as being provisionally unpatentable over claims 16 and 17 of co-pending U.S. Patent Application No. 08/814,319 in view of *Ferguson*.

(7) ARGUMENT

A. Introduction

The Patent Office has not established a *prima facie* case of obviousness of the claimed invention. More specifically, the Patent Office has not shown where the cited references, either alone or in combination, disclose periodically sending subscription-based content to a subscribing client node. In addition, the Patent Office has not shown how the prior art discloses charging a fee to providers of the subscription-based content for serving the subscription-based content. Moreover, the Patent Office has not demonstrated how the cited references disclose paying affiliate server owners a percentage of a fee charged for serving a file. As such, the Appellants request that the Board reverse the Examiner and instruct the Examiner to allow the claims for these reasons.

B. Summary Of The References

1. U.S. Patent Application Publication No. 2002/0062290 A1 To *Ricci*

Ricci relates to licensing transferred digital media. (See *Ricci*, paragraph **[0002]**). In particular, *Ricci* relates to a method of sharing digital media across a network. (See *Ricci*, paragraph **[0021]**). Furthermore, *Ricci* discloses that both licensed and unlicensed media may be transferred by paying a royalty. (See *Ricci*, paragraph **[0031]**). However, nowhere does *Ricci* disclose periodically sending subscription-based content to a subscribing client node. In addition, *Ricci* does not disclose charging a fee to providers of the subscription-based content for serving the subscription-based content. *Ricci* also does not disclose paying affiliate server owners a percentage of a fee charged for serving a file.

2. U.S. Patent No. 5,819,092 To *Ferguson*

Ferguson relates to online computer services. (See *Ferguson*, col. 1, ll. 12-13). *Ferguson* discloses levying fees against third party content owners for executing a transaction. (See *Ferguson*, col. 4, ll. 53-60). In addition, *Ferguson* discloses a fee setting tool, which enables a user to set fees associated with an online service for an entity. Nevertheless, *Ferguson* does not disclose periodically sending subscription-based content to a subscribing client node. Moreover, *Ferguson* does not disclose charging a fee to providers of the subscription-based content for serving the subscription-based content nor paying affiliate server owners a percentage of a fee charged for serving a file.

3. *ARA*

The Specification of the present application reads in part: "As is well known in the art, in cost per click, the advertiser is charged a fee based on how many times users click on a displayed ad, while in cost per acquisition, the advertiser is based on how many new customers are acquired through the ads." (Specification, p. 8, lines 8-11). However, the *ARA* does not disclose periodically sending subscription-based content to a subscribing client node. Furthermore, the *ARA* does not disclose charging a fee to providers of the subscription-based content for serving the subscription-based content. In addition, the *ARA* does not disclose paying affiliate server owners a percentage of a fee charged for serving a file.

C. Legal Standards for Establishing Obviousness

Section 103(a) of the Patent Act provides the statutory basis for an obviousness rejection and reads as follows:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Courts have interpreted 35 U.S.C. § 103(a) as a question of law based on underlying facts. As the Federal Circuit stated:

> Obviousness is ultimately a determination of law based on underlying determinations of fact. These underlying factual determinations include: (1) the

> scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) the extent of any proffered objective indicia of nonobviousness.

Monarch Knitting Mach. Corp. v. Sulzer Morat GmBH, 45 U.S.P.Q.2d (BNA) 1977, 1981 (Fed. Cir. 1998) (internal citations omitted).

Once the scope of the prior art is ascertained, the content of the prior art must be properly combined. An obviousness inquiry requires looking at a number of factors, including the background knowledge possessed by a person having ordinary skill in the art, to determine whether there was an apparent reason to combine the elements of the prior art in the fashion claimed by the present invention. *KSR Int'l v. Teleflex, Inc.*, 550 U.S. __, 82 U.S.P.Q.2d (BNA) 1385, 1396 (2007). "Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demand known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit. See *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness")." *KSR*, 550 U.S. __, 82 U.S.P.Q.2d at 1396 (2007).

While the Patent Office is entitled to give claim terms their broadest reasonable interpretation, this interpretation is limited by a number of factors. First, the interpretation must be consistent with the specification. *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000); MPEP § 2111. Second, the broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, (Fed. Cir. 1999); MPEP § 2111. Finally, the interpretation must be reasonable. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1369 (Fed. Cir. 2004); MPEP § 2111.01. This means that the words of the claim must be given their plain meaning unless Appellant has provided a clear definition in the specification. *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989).

If a claim element is missing after the combination is made, then the combination does not render obvious the claimed invention, and the claims are allowable. As stated by the Federal

Circuit, "[if] the PTO fails to meet this burden, then the Appellant is entitled to the patent." *In re Glaug*, 283 F.3d 1335, 1338 (Fed. Cir. 2002).

D. Claims 1-6, 9-14, 17-22, And 26-29 Are Non-Obvious Over *Ricci* In View Of *Ferguson*

Claims 1-6, 9-14, 17-22, and 26-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ricci* in view of *Ferguson*. The Appellants respectfully traverse the rejection.

1. None Of The References, Either Alone Or In Combination, Disclose Periodically Sending Subscription-Based Content To A Subscribing Client Node

According to Chapter 2143.03 of the M.P.E.P., in order to "establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." The Appellants submit that neither *Ricci* nor *Ferguson*, either alone or in combination, discloses all the features recited in claims 1-6, 9-14, 17-22, and 26-29. More specifically, claim 1 recites a method for generating revenue in a peer-to-peer file delivery network comprising, among other features, "periodically sending the subscription-based content to each respective subscribing client node." Claim 17 includes similar features. The Appellants submit that none of the references, either alone or in combination, disclose periodically sending subscription-based content to a subscribing client node. In maintaining the rejection, the Patent Office asserts that *Ricci* discloses this feature in paragraph **[0040]**. (See Final Office Action mailed February 4, 2008, page 7). The Appellants respectfully disagree. At most, the cited portion of *Ricci* discloses that during the transfer of digital media, a network acts like a peer-to-peer network without requiring a central server. (See *Ricci*, paragraph **[0040]**). However, no mention is made of periodically sending subscription-based content to a subscribing client node. Furthermore, the Appellants have reviewed the remainder of the reference and submit that nowhere does *Ricci* disclose this feature. Likewise, the Appellants have reviewed *Ferguson* and submit that *Ferguson* does not disclose periodically sending subscription-based content to a subscribing client node.

The Patent Office addresses this rejection by asserting that *Ricci* discloses subscription services. In particular, the Patent Office indicates that *Ricci* discloses collecting royalties without charging subscription fees and those royalties may be traditional charges, such as a

subscription fee, as disclosed in paragraph **[0030]** of *Ricci*. (See Final Office Action mailed February 4, 2008, page 2). The Patent Office goes on to state that *Ricci* discloses that royalties are based on a number of uses where a quantity is equivalent to the number of uses, as disclosed in paragraph **[0053]** of *Ricci*. (See Final Office Action mailed February 4, 2008, page 2). Regarding the disclosure in paragraph **[0030]** of *Ricci*, the Appellants respectfully disagree. The Appellants are not arguing that *Ricci* does not disclose subscription services. However, the Appellants are not capitulating that *Ricci* does in fact disclose subscription services. Instead, the Appellants are arguing that *Ricci* does not disclose periodically sending subscription-based content.

Regarding the disclosure in paragraph **[0053]** of *Ricci*, the Appellants respectfully submit that the disclosure in this paragraph is not available as prior art against the present application. More specifically, the present application has a filing date of September 26, 2001, well before the filing date of *Ricci*, which is December 18, 2001. *Ricci* claims the benefit of provisional application no. 60/252,334 having a filing date of November 22, 2000 (hereinafter "*provisional application*"). Nonetheless, the subject matter of paragraph **[0053]** is not disclosed in the *provisional application*. Therefore, this subject matter is not available as prior art against the present application.

Nevertheless, the Patent Office indicates that pages 8-10 of the *provisional application* disclose periodically sending subscription-based content to a subscribing client node. (See Advisory Action mailed April 29, 2008, page 2). The Appellants respectfully disagree. While pages 8-10 of the *provisional application* disclose sending advertisements, no mention is made about periodically sending the advertisements to a subscribing client node. (See *provisional application*, pages 9 and 10). At most, the *provisional application* discloses that certain advertisers are partnered with digital data that is being downloaded to a user and will send advertisements based on a tag received by the user. (See *provisional* application, page 9, l. 39 through page 10, l. 2). However, the *provisional application* does not indicate that the user subscribes to the advertisements. Thus, even if the user receives the advertisements, this is not equivalent to periodically sending subscription-based content to each respective subscribing client node.

The Patent Office also asserts that *Ferguson* discloses this feature in col. 9, ll. 2-9. (See Final Office Action mailed February 4, 2008, page 2). The Appellants respectfully disagree.

While the cited portion of *Ferguson* does disclose an online service, which may charge or pay a user of a content provider, nowhere does the cited portion disclose periodically sending subscription-based content to a subscribing client node. (See *Ferguson*, col. 9, ll. 4-5).

2. None Of The References, Either Alone Or In Combination, Disclose Charging A Fee To Providers Of Subscription-Based Content For Serving Subscription-Based Content

Claim 1 also recites "charging a fee to providers of the subscription-based content for serving the subscription-based content." Claim 17 includes similar features. The Appellants submit that none of the references, either alone or in combination, disclose charging a fee to providers of subscription-based content for serving the subscription-based content. As correctly pointed out by the Patent Office, *Ricci* does not disclose this feature. (See Examiner's Answer mailed October 30, 2007, page 4; and Final Office Action mailed February 4, 2008, page 8). Similarly, *Ferguson* does not disclose this feature. Nevertheless, the Patent Office supports the rejection by stating that *Ferguson* discloses this feature in col. 4, ll. 53-60. (See Examiner's Answer mailed October 30, 2007, page 4). The Appellants respectfully disagree. While the cited portion of *Ferguson* does disclose levying fees against third party content owners for executing a transaction, *Ferguson* does not disclose charging a fee for subscription-based content. (See *Ferguson*, col. 4, ll. 53-60). Likewise, the Appellants have reviewed the remaining portions of *Ferguson* and submit that nowhere does the reference disclose this feature. Accordingly, for at least this reason, claims 1 and 17 are patentable over the cited references. Similarly, claims 2, 4-6, 18, and 20-22, which ultimately depend from claim 1 or 17, are patentable for at least the same reasons along with the novel features recited therein.

3. None Of The References, Either Alone Or In Combination, Disclose A Means For Enabling Downloads Of Subscription-Based Content In Order To Receive Periodic Updates

Claim 9 recites a system for generating revenue in a peer-to-peer file delivery network comprising, among other features, "means for enabling decentralized downloads of subscription-based content that client nodes of the multiple client nodes subscribe to in order to receive periodic updates." The Appellants respectfully submit that none of the references, either alone or in combination, disclose a means for enabling downloads of subscription-based content in order

to receive periodic updates. As detailed above, none of the references, either alone or in combination, disclose periodically sending subscription-based content to a subscribing client node. Therefore, it follows that neither reference, either alone or in combination, can disclose receiving periodic updates nor a means for enabling downloads of subscription-based content in order to receive periodic updates.

4. None Of The References, Either Alone Or In Combination, Disclose Charging A Fee To Providers Of Subscription-Based Content For Serving Subscription-Based Content

Claim 9 also recites that "a fee is charged to providers of subscription-based content for serving the subscription-based content to the client nodes." As detailed above, none of the references, either alone or in combination, disclose charging a fee to providers of subscription-based content for serving subscription-based content. As such, for this reason and the reason noted above, claim 9 is patentable over the cited references. Similarly, claims 10 and 12-14, which ultimately depend from claim 9, are patentable for at least the same reasons along with the novel features recited therein.

5. None Of The References, Either Alone Or In Combination, Disclose Periodically Sending Subscription-Based Content To A Subscribing Client Node Nor Charging A Fee To Providers Of The Subscription-Based Content For Serving The Subscription-Based Content

Claim 26 recites a method for generating revenue in a peer-to-peer file delivery network, comprising, among other features, "periodically sending the subscription-based content to each respective subscribing client node." As detailed above, none of the references, either alone or in combination, disclose periodically sending subscription-based content to a subscribing client node. Claim 26 also recites "charging a fee to providers of the subscription-based content for serving the subscription-based content." As previously discussed, neither *Ricci* nor *Ferguson*, either alone or in combination, discloses charging a fee to providers of the subscription-based content for serving the subscription-based content.

6. None Of The Cited References, Either Alone Or In Combination, Disclose Paying Affiliate Server Owners A Percentage Of A Fee Charged For Serving A File

Moreover, claim 26 recites enabling clients to become affiliate servers and paying affiliate server owners "a percentage of the fee charged for serving files." The Appellants submit that none of the cited references, either alone or in combination, disclose paying affiliate server owners a percentage of a fee charged for serving a file. As correctly pointed out by the Patent Office, *Ricci* does not disclose this feature. (See Examiner's Answer mailed October 30, 2007, page 6). Likewise, *Ferguson* does not disclose this feature. Nonetheless, the Patent Office supports the rejection by asserting that *Ferguson* discloses this feature in col. 15, ll. 7-11, col. 4, ll. 53-60, col. 14, ll. 30-31, and col. 9, ll. 2-9. (See Examiner's Answer mailed October 30, 2007, pages 6 and 7). The Appellants respectfully disagree. At most, the cited portions of *Ferguson* disclose levying fees against third party content owners for executing a transaction and that a server may charge or pay a user or a content provider a fee. (See *Ferguson*, col. 4, ll. 58-60 and col. 9, ll. 2-5; see also Figure 2, step 240). However, nowhere do the cited portions, nor anywhere else in *Ferguson* for that matter, disclose paying an affiliate server owner a percentage of a fee charged for serving files.

The Patent Office addresses this argument by stating that in *Ferguson* the teaching of paying a content provider or user for a digital media transaction in combination with the disclosure in *Ricci* relating to peer-to-peer file sharing discloses the feature of paying affiliate server owners a percentage of a fee charged for serving a file. (See Final Office Action mailed February 4, 2008, page 6). Moreover, the Patent Office asserts that allowing other client nodes to download files from their system is a basic economical decision wherein a resource supplier is reimbursed for their resource. (See Final Office Action mailed February 4, 2008, page 6). The Appellants fail to recognize how combining the teaching of paying a content provider or a user for digital media transaction with the teaching of peer-to-peer file sharing discloses paying affiliate server owners a <u>percentage</u> of a fee charged for serving a file. Even assuming, *arguendo*, that allowing other client nodes to download files from their system is a basic economical decision wherein a resource supplier is reimbursed for their resource, nowhere does either reference, either in the cited portion or anywhere else, disclose anything about percentages, much less paying affiliate server owners a percentage of a fee charged for serving a

file. For this reason and the reasons noted above, claim 26 is patentable over the cited references and the Appellants request that the rejection be withdrawn.

Claim 3, which depends from claim 1, recites enabling clients to become affiliate servers and paying affiliate server owners "a percentage of the fee charged for serving files." Claim 11, which depends from claim 9, and claim 19, which depends from claim 17, include similar features. As detailed above, none of the cited references, either alone or in combination, disclose paying affiliate server owners a percentage of a fee charged for serving a file. For this reason and the reasons noted above with reference to claims 1, 9, and 17, claims 3, 11, and 19 are patentable over the cited references.

7. None Of The References, Either Alone Or In Combination, Disclose A Means For Enabling Downloads Of Subscription-Based Content In Order To Receive Periodic Updates Charging A Fee To Providers Of The Subscription-Based Content For Serving The Subscription-Based Content Nor Paying Affiliate Server Owners A Percentage Of A Fee Charged For Serving A File

Claim 27 recites a system for generating revenue in a peer-to-peer system comprising, among other features, "means for enabling decentralized downloads of subscription-based content that client nodes of the multiple client nodes subscribe to in order to receive periodic updates." As detailed above, none of the references, either alone or in combination, disclose a means for enabling downloads of subscription-based content in order to receive periodic updates. Claim 27 also recites that "a fee is charged to providers of the subscription-based content for serving the subscription-based content to the client nodes." As previously mentioned, none of the references, either alone or in combination, disclose charging a fee to providers of subscription-based content for serving subscription-based content. Moreover, claim 27 recites "means for enabling client nodes to become affiliate servers that deliver content to other client nodes, such that owners of the affiliate servers are paid a percentage of the fee charged for serving files." As discussed above, neither *Ricci* nor *Ferguson*, either alone or in combination, discloses paying affiliate server owners a percentage of a fee charged for serving a file. Thus, neither reference, either alone or in combination, can disclose a means having this functionality. For at least all of these reasons, claim 27 is patentable over the cited references.

8. Neither *Ricci* Nor *Ferguson*, Either Alone Or In Combination, Discloses Charging A Fee Based On A Quantity Of Content Served When A Client Downloads Content And Then Charging A Second Fee To Providers Of Subscription-Based Content When Subscription-Based Content Is Served To Client Nodes

Claim 28 recites a system for generating revenue in a peer-to-peer file delivery network comprising, among other features, charging a fee based on a quantity of content served when a client downloads content and then charging a second fee to providers of subscription-based content when subscription-based content is served to client nodes. The Appellants have reviewed both *Ricci* and *Ferguson* and submit that neither of the references, either alone or in combination, discloses charging a fee based on a quantity of content served when a client downloads content and then charging a second fee to providers of subscription-based content when subscription-based content is served to client nodes. Accordingly, claim 28 is patentable over the cited references.

9. None Of The References, Either Alone Or In Combination, Disclose Charging A Fee To Providers Of The Subscription-Based Content For Serving The Subscription-Based Content Nor Paying Affiliate Server Owners A Percentage Of A Fee Charged For Serving A File

Claim 29 recites a server node comprising, among other features, charging a fee "to providers of the subscription-based content for providing the subscription-based content to the client node." As mentioned above, neither *Ricci* nor *Ferguson*, either alone or in combination, discloses charging a fee to providers of subscription-based content for serving subscription-based content. Claim 29 also recites that a client node may become an affiliate server such that an affiliate server owner "is paid a percentage of a fee charged for content delivery." As mentioned above, none of the references, either alone or in combination, disclose paying affiliate server owners a percentage of a fee charged for serving a file. For these reasons, claim 29 is patentable over the cited references.

E. Claims 7, 8, 15, 16, And 23-25 Are Non-Obvious Over *Ricci* In View Of *Ferguson* And Further In View Of The *ARA*

In addition, claims 7, 8, 15, 16, and 23-25 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Ricci* in view of *Ferguson* and further in view of the *ARA*. The Appellants respectfully traverse the rejection. Regarding claims 7, 8, 15, 16, 23, and 24, as detailed above,

claims 1, 9, and 17, the base claims from which claims 7, 8, 15, 16, 23, and 24 ultimately depend, are patentable over *Ricci* and *Ferguson*. Moreover, the *ARA* does not overcome the previously noted shortcomings of both *Ricci* and *Ferguson*. Therefore, claims 7, 8, 15, 16, 23, and 24 are patentable over the cited references.

1. None Of The References, Either Alone Or In Combination, Disclose Periodically Sending Subscription-Based Content To A Subscribing Client Node

Claim 25 recites a method for providing subscription-based decentralized file downloads to client nodes in a peer-to-peer public network comprising, among other features, "periodically delivering the particular content files to respective clients nodes that subscribed to the particular content files." As detailed above, neither *Ricci* nor *Ferguson*, either alone or in combination, discloses periodically delivering content files to clients that subscribed to particular client files. In addition, the *ARA* does not disclose this feature. Accordingly, claim 25 is patentable over the cited references.

F. Claims 1-27 Were Provisionally Rejected Under The Judicially Created Doctrine Of Obviousness-Type Double Patenting As Being Unpatentable Over Claims 16 And 17 Of Co-Pending U.S. Patent Application No. 08/814,319 In View Of *Ferguson*

Claims 1-27 were also provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 16 and 17 of co-pending Application No. 08/814,319 in view of *Ferguson*. In an effort to expedite prosecution, the Appellants will file a terminal disclaimer if the pending claims are found to be in a condition of allowance.

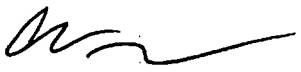
G. Conclusion

As detailed above, the Patent Office has not established where the cited references, either alone or in combination, disclose periodically sending subscription-based content to a subscribing client node. Moreover, as shown above, the Patent Office has not shown how the prior art, either alone or in combination, discloses charging a fee to providers of subscription-based content for serving the subscription-based content or paying affiliate server owners a

percentage of a fee charged for serving a file. As such, the Appellants request that the Board reverse the Examiner and instruct the Examiner to allow the claims for these reasons.

Respectfully submitted,

WITHROW & TERRANOVA, P.L.L.C.

By: 

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Date: August 1, 2008
Attorney Docket: 1104-032

(8) APPENDIX

1. A method for generating revenue in a peer-to-peer file delivery network, the peer-to-peer file delivery network including at least one server node and multiple client nodes, the method comprising the steps of:

(a) enabling peer-to-peer file sharing of content by,

(i) initiating on one client node a download of a particular content item served from the server node or another client node, and

(ii) charging a fee based on a quantity of content served related to the particular content item; and

(b) enabling decentralized downloads of subscription-based content by

(i) allowing client nodes of the multiple client nodes to subscribe to the subscription-based content,

(ii) periodically sending the subscription-based content to each respective subscribing client node, and

(iii) charging a fee to providers of the subscription-based content for serving the subscription-based content.

2. The method of claim 1 further including the step of:

(c) providing direct marketing by

(i) sending marketing content to the client nodes from the server node as well as from other client nodes, and

(ii) charging a fee to providers of the marketing content.

3. The method of claim 1 further including the step of:

(d) enabling client nodes to become affiliate servers that deliver content to other client nodes, and paying owners of the affiliate servers a percentage of the fee charged for serving files.

4. The method of claim 1 wherein the content includes free content and fee-based content, step (a)(ii) further including the steps of:

(1) charging a fee to a provider of the free content for serving the free content, and

(2) charging a fee to a user of the initiating client node for the download of the fee-based content.

5. The method of claim 4 wherein the subscription-based content includes free content and fee-based content, step (b)(iii) further including the step of:

(1) charging a fee to users of the subscribing client nodes for receiving the fee-based content.

6. The method of claim 4 wherein the subscription-based content includes free content and fee-based content, step (b)(iii) further including the step of charging a fee to users of the subscribing client nodes for opening the fee-based content.

7. The method of claim 2 wherein step (c)(ii) further includes the step of: charging a fee to the provider of the marketing content based on a cost per click.

8. The method of claim 7 wherein step (c)(ii) further includes the step of: charging a fee to the provider of the marketing content based on a cost per acquisition.

9. A system for generating revenue in a peer-to-peer file delivery network, the peer-to-peer file delivery network including at least one server node and multiple client nodes, the system comprising:

means for enabling peer-to-peer file sharing of content whereby one client node initiates a download of a particular content item served from the server node or another client node, and wherein a fee is charged based on a quantity of content served related to the particular content item; and

means for enabling decentralized downloads of subscription-based content that client nodes of the multiple client nodes subscribe to in order to receive periodic updates, wherein a fee is charged to providers of subscription-based content for serving the subscription-based content to the client nodes.

10. The system of claim 9 further including means for providing direct marketing to client

nodes such that marketing content is sent to the client nodes from the server node as well as from other client nodes, and a fee is charged to providers of the marketing content.

11. The system of claim 9 further including means for enabling client nodes to become affiliate servers that deliver content to other client nodes, such that owners of the affiliate servers are paid a percentage of the fee charged for serving files.

12. The system of claim 9 wherein the content includes free content and fee-based content, and a provider of the free content is charged a fee for serving the free content, and a user of the initiating client node is charged a fee for download of the fee-based content.

13. The system of claim 12 wherein the subscription-based content includes second free content and second fee-based content, and wherein users of subscribing client nodes are charged a fee for receiving the second fee-based content.

14. The system of claim 12 wherein the subscription-based content includes second free content and second fee-based content, and wherein users of the subscribing client nodes are charged a fee for opening the second fee-based content.

15. The system of claim 10 further comprising means for charging a fee from a provider of the marketing content based on a cost per click.

16. The system of claim 15 further comprising means for charging a fee from the provider of the marketing content based on a cost per acquisition.

17. A computer-readable medium containing program instructions for generating revenue in a peer-to-peer file delivery network, the peer-to-peer file delivery network including at least one server node and multiple client nodes, the program instructions for:

(a) enabling peer-to-peer file sharing of content by,

(i) initiating on one client node a download of a particular content item served from the server node or another client node, and

(ii) charging a fee based on a quantity of content served related to the particular content item; and

(b) enabling decentralized downloads of subscription-based content by

(i) allowing client nodes of the multiple client nodes to subscribe to subscription-based content,

(ii) periodically sending the subscription-based content to each respective subscribing client node, and

(iii) charging a fee to providers of the subscription-based content for serving the subscription-based content.

18. The computer-readable medium of claim 17 further including the instruction of:

(c) providing direct marketing by

(i) sending marketing content to the client nodes from the server node as well as from other client nodes, and

(ii) charging a fee to providers of the marketing content.

19. The computer-readable medium of claim 17 further including the instruction of:

(d) enabling client nodes to become affiliate servers that deliver content to other client nodes, and paying owners of the affiliate servers a percentage of the fee charged for serving files.

20. The computer-readable medium of claim 17 wherein the content includes free content and fee-based content, instruction (a)(ii) further including the instructions of:

(1) charging a fee to a provider of the free content for serving the free content, and

(2) charging a fee to a user of an initiating client node for download of the fee-based content.

21. The computer-readable medium of claim 20 wherein the subscription-based content includes second free content and second fee-based content, instruction (b)(iii) further including the instruction of:

(1) charging a fee to users of the respective subscribing client node for receiving the second fee-based content.

22. The computer-readable medium of claim 20 wherein the subscription-based content includes second free content and second fee-based content, instruction (b)(iii) further including the instruction of charging a fee to users of the respective subscribing client nodes for opening the second fee-based content.

23. The computer-readable medium of claim 18 wherein instruction (c)(ii) further includes the instruction of:

charging a fee to the providers of the marketing content based on a cost per click.

24. The computer-readable medium of claim 23 wherein instruction (c)(ii) further includes the instruction of:

charging a fee to the providers of the marketing content based on a cost per acquisition.

25. A method for providing subscription-based decentralized file downloads to client nodes in a peer-to-peer public network, each of the client nodes affiliated with a user account, the method comprising the steps of:

(a) receiving content files from at least one content provider, the content including free subscription content files, fee-based subscription content files, and marketing content files;

(b) allowing the client nodes to subscribe to particular content files;

(c) periodically delivering the particular content files to respective clients nodes that subscribed to the particular content files;

(d) charging the at least one content provider a fee for delivering the content files to the client nodes over the peer-to-peer public network;

(e) charging the at least one content provider a fee for the marketing content files based on a number of users that access the marketing content files once downloaded; and

(f) charging user accounts of the client nodes that received fee-based subscription content files.

26. A method for generating revenue in a peer-to-peer file delivery network, the network including at least one server node and multiple client nodes, the method comprising the steps of:

(a) enabling peer-to-peer file sharing of content by,

(i) initiating on one client node a download of a particular content item served from the at least one server node or another client node, and

(ii) charging a fee based on a quantity of content served related to the particular content item;

(b) enabling decentralized downloads of subscription-based content by

(i) allowing client nodes of the multiple client nodes to subscribe to the subscription-based content,

(ii) periodically sending the subscription-based content to each respective subscribing client node, and

(iii) charging a fee to providers of the subscription-based content for serving the subscription-based content;

(c) providing direct marketing by

(i) sending marketing content to the client nodes from the at least one server node as well as from other client nodes, and

(ii) charging a fee to providers of the marketing content; and

(d) enabling client nodes to become affiliate servers that deliver content to other client nodes, and paying owners of the affiliate servers a percentage of the fee charged for serving files.

27. A system for generating revenue in a peer-to-peer file delivery network, the peer-to-peer file delivery network including at least one server node and multiple client nodes, the system comprising:

means for enabling peer-to-peer file sharing of content whereby one client node initiates a download of a particular content item served from the at least one server node or another client node, and wherein a fee is charged based on a quantity of content served related to the particular content item;

means for enabling decentralized downloads of subscription-based content that client nodes of the multiple client nodes subscribe to in order to receive periodic updates, wherein a fee is charged to providers of the subscription-based content for serving the subscription-based content to the client nodes;

means for providing direct marketing to the client nodes such that marketing content is sent to the client nodes from the at least one server node as well as from other client nodes, and a fee is charged to providers of the marketing content; and

means for enabling client nodes to become affiliate servers that deliver content to other client nodes, such that owners of the affiliate servers are paid a percentage of the fee charged for serving files.

28. A system for generating revenue in a peer-to-peer file delivery network, comprising:

a server node adapted to:

allow a download by a client node, wherein a fee is charged based on a quantity of content served during the download; and

enable downloads of subscription-based content by client nodes, wherein a second fee is charged to providers of the subscription-based content for serving the subscription based content to the client nodes.

29. A server node comprising:

a network interface; and

a control system adapted to:

share content with a client node and charge a fee based on a quantity of content shared with the client node;

provide subscription-based content to which the client node may subscribe, wherein a fee is charged to providers of the subscription-based content for providing the subscription-based content to the client node; and

provide direct marketing to the client node such that marketing content is provided to the client node and a fee is charged to providers of the marketing content; and

wherein the client node may become an affiliate server that delivers content to other client nodes such that an owner of the affiliate server is paid a percentage of a fee charged for content delivery.

(9) EVIDENCE APPENDIX

The Appellants rely on no evidence, thus this appendix is not applicable.

(10) RELATED PROCEEDINGS APPENDIX

This Appeal Brief is related to a Notice of Appeal filed on July 7, 2006, and an Appeal Brief filed on December 6, 2006. In response to the Appeal Brief filed on December 6, 2006, an Examiner's Answer was mailed on February 27, 2007. The Appellants filed a Reply Brief on April 24, 2007.

The Appeal Brief filed on December 6, 2006 was undockected and returned to the Examiner for clarification of the claims status on October 5, 2007. A Revised Examiner's Answer was mailed on October 30, 2007 to which the Appellants filed a response on December 27, 2007. Prosecution was then reopened through the mailing of a Final Office Action on February 4, 2008. The Appellants filed a response to the Final Office Action on April 3, 2008. The Examiner responded with an Advisory Action mailed April 29, 2008. In response to the Advisory Action, the Appellants filed a new Notice of Appeal on May 13, 2008. This Appeal Brief is filed in response to the Final Office Action mailed February 4, 2008 and the Advisory Action mailed April 29, 2008. A copy of each of these documents is attached as Appendix A.

Appendix A

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Signature: Michelle Heymann
Typed or printed name: Michelle Heymann

In re Application of: Schleicher et al.

Application Number	Filed
09/963,812	9/26/2001

For: METHOD AND SYSTEM FOR GENERATING REVENUE IN A PEER-TO-PEER FILE DELIVERY NETWORK

Art Unit	Examiner
3639	Fadey S. Jabr

Applicant hereby appeals to the Board of Patent Appeals and Interferences from the last decision of the examiner.

The fee for this Notice of Appeal is (37 CFR 1.17(b)) $ 500.00

- ☐ Applicant claims small entity status. See 37 CFR 1.27. Therefore, the fee shown above is reduced by half, and the resulting fee is: $ _____
- ☐ A check in the amount of the fee is enclosed.
- ☑ Payment by credit card. Form PTO-2038 is attached.
- ☐ The Director has already been authorized to charge fees in this application to a Deposit Account. I have enclosed a duplicate copy of this sheet.
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- ☐ A petition for an extension of time under 37 CFR 1.136(a) (PTO/SB/22) is enclosed.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- ☑ attorney or agent of record. Registration number 40,876
- ☐ attorney or agent acting under 37 CFR 1.34(a). Registration number if acting under 37 CFR 1.34(a). _____

Signature

Benjamin S. Withrow
Typed or printed name

919-654-4520
Telephone number

July 7, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

PTO-2038 (02-2000)
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Credit Card Payment Form
Please Read Instructions before Completing this Form

Credit Card Information

Credit Card Type:	Visa	MasterCard	American Express	Discover

Credit Card Account #: [redacted]

Credit Card Expiration Date: 04/2007

Name as it Appears on Credit Card: Benjamin S. Withrow, Withrow & Terranova

Payment Amount: $(US Dollars): 500.00

Signature: | Date: July 7, 2006

Refund Policy: The Office may refund a fee paid by mistake or in excess of that required. A change of purpose after the payment of a fee will not entitle a party to a refund of such fee. The Office will not refund amounts of twenty-five dollars or less unless a refund is specifically requested, and will not notify the payor of such amounts (37 CFR 1.26). Refund of a fee paid by credit card will be via credit to the credit card account.
Service Charge: There is a 50.00 service charge for processing each payment refused (including a check returned "unpaid") or charged back by a financial institution (37 CFR 1.21(m)).

Credit Card Billing Address

Street Address 1: 201 Shannon Oaks Circle

Street Address 2: Suite 200

City: Cary

State: North Carolina | Zip/Postal Code: 27511

Country: U.S.A.

Daytime Phone #: (919) 654-4520 | Fax #: (919) 654-4521

Request and Payment Information

Description of Request and Payment Information:
$500.00 payment for notice of appeal

Patent Fee	Patent Maintenance Fee	Trademark Fee	Other Fee
Application No. 09/963,812	Application No.	Serial No.	IDON Customer No.
Patent No.	Patent No.	Registration No.	
Attorney Docket No. 1104-032		Identify or Describe Mark	

If the cardholder includes a credit card number on any form or document other than the Credit Card Payment Form, the United States Patent & Trademark Office will not be liable in the event that the credit card number becomes public knowledge.

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Electronic Acknowledgement Receipt

EFS ID:	1355716
Application Number:	09963812
International Application Number:	
Confirmation Number:	1207
Title of Invention:	DOCKETED MK 12/6/06 Method and system for generating revenue in a peer-to-peer file delivery network
First Named Inventor/Applicant Name:	Jorg Gregor Schleicher
Customer Number:	27820
Filer:	Benjamin Withrow/Michelle Heymann
Filer Authorized By:	Benjamin Withrow
Attorney Docket Number:	2060P
Receipt Date:	06-DEC-2006
Filing Date:	26-SEP-2001
Time Stamp:	14:37:19
Application Type:	Utility

Payment information:

Submitted with Payment	yes
Payment was successfully received in RAM	$1520
RAM confirmation Number	1520
Deposit Account	

File Listing:

Document Number	Document Description	File Name	File Size(Bytes)	Multi Part /.zip	Pages (If appl.)

1	Appeal Brief Filed	Appeal_Brief_12-6-06.pdf	1235813	no	28
Warnings:					
Information:					
2	Fee Worksheet (PTO-875)	fee-info.pdf	8356	no	2
Warnings:					
Information:					
		Total Files Size (in bytes):	1244169		

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New Applications Under 35 U.S.C. 111

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

Electronic Patent Application Fee Transmittal

Application Number:	09963812
Filing Date:	26-Sep-2001
Title of Invention:	Method and system for generating revenue in a peer-to-peer file delivery network
First Named Inventor/Applicant Name:	Jorg Gregor Schleicher
Filer:	Benjamin Withrow/Michelle Heymann
Attorney Docket Number:	2060P

Filed as Large Entity

Utility Filing Fees

Description	Fee Code	Quantity	Amount	Sub-Total in USD($)
Basic Filing:				
Pages:				
Claims:				
Miscellaneous-Filing:				
Petition:				
Patent-Appeals-and-Interference:				
Filing a brief in support of an appeal	1402	1	500	500
Post-Allowance-and-Post-Issuance:				
Extension-of-Time:				

Description	Fee Code	Quantity	Amount	Sub-Total in USD($)
Extension - 3 months with $0 paid	1253	1	1020	1020
Miscellaneous:				
		Total in USD ($)		**1520**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Jorg G. Schleicher
Serial No. 09/963,812
Filed: 09/26/2001
Examiner: Fadey S. Jabr
Art Unit: 3639
For: **METHOD AND SYSTEM FOR GENERATING REVENUE IN A PEER-TO-PEER FILE DELIVERY NETWORK**

Mail Stop Appeal Brief – Patents
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

An **APPEAL BRIEF** is filed herewith. Appellant also encloses a payment in the amount of $1520.00 to cover the fee associated with this appeal brief as required by 37 C.F.R. § 1.17(c) and the fee associated with a three-month extension of time. If any additional fees are required in association with this appeal brief, the Director is hereby authorized to charge them to Deposit Account 50-1732, and consider this a petition therefor.

APPEAL BRIEF

(1) REAL PARTY IN INTEREST

The real party in interest is the assignee of record, i.e., Qurio Holdings, Inc. of 1130 Situs Court, Suite 216, Raleigh, NC 27606.

(2) RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences to the best of Appellant's knowledge.

(3) STATUS OF CLAIMS

Claims 1-27 were rejected with the rejection made final on March 8, 2006.

Claims 28 and 29 were added by amendment in response to the initial non-final office action (see Appellant's Office Action Response transmitted January 6, 2006), but were not addressed in the Final Office Action mailed March 8, 2006 or in the Advisory Action mailed June 6, 2006.

Claims 1-27 are pending and are the subject of this appeal. However, Appellant respectfully submits that claims 28 and 29, which were added by amendment in Appellant's

Office Action Response transmitted January 6, 2006, should also be pending, given that claims 28 and 29 were added prior to a final Office Action.

(4) STATUS OF AMENDMENTS

The Advisory Action mailed June 6, 2006 indicates that the only claims 1-27 were rejected. Claims 28 and 29, which were added in Appellant's Office Action Response transmitted January 6, 2006, have apparently not been entered. As mentioned above, claims 28 and 29 were added by amendment in Appellant's Office Action Response transmitted January 6, 2006. Claims 28 and 29 correspond to claims 9 and 27 but without the means plus function language. Appellant respectfully requests that claims 28 and 29 be added for purposes of the appeal since they were added prior to the final office action and are similar to claims already in the appeal.

(5) SUMMARY OF CLAIMED SUBJECT MATTER

The present invention provides a method and system for generating revenue in a peer-to-peer file delivery network. The method and system include enabling peer-to-peer file sharing of content by initiating, on one client node, a download of a particular content item served from the server node or another client node, and then charging a fee based on a quantity of the content served (Specification, p. 4, lines 19-23). The method and system further include enabling decentralized downloads of subscription-based content. The decentralized downloads are provided by allowing the client nodes to subscribe to one or more of the subscription-based content, periodically sending the subscribed to subscription-based content to each the respective subscribing client nodes, and then charging a fee to providers of the subscription-based content for serving the subscription-based content (Specification, p. 5, lines 1-6).

Another aspect of the present invention includes providing direct marketing wherein users on the network are targeted with direct marketing material and providers of the marketing content are charged for the service (Specification, p. 5, lines 8-10). A further aspect of the present invention includes enabling client nodes to become affiliate servers nodes that deliver content to other client nodes, thus taking advantage of idle bandwidth (Specification, p 5, lines 10-13). As an incentive, the owners of the affiliate servers may be paid a percentage of the fee charged for serving the files to the other client nodes (Specification, p 5, lines 13-14).

In particular, claim 1 recites a method for generating revenue in a peer-to-peer file delivery network (such as network 10, Figure 1A), the peer-to-peer file delivery network including at least one server node (such as server node 12, Figure 1A; see also Figure 1B) and multiple client nodes (such as client nodes 14, Figure 1A), the method comprising the steps of:

(a) enabling peer-to-peer file sharing of content (Specification, p. 9, lines 1-2; see also Figure 2, step 42) by,

(i) initiating on one client node a download of a particular content item served from the server node or another client node (Specification, p. 4, lines 20-22, p. 9, lines 3-7), and

(ii) charging a fee based on a quantity of content served related to the particular content item (Specification, p. 4, lines 22-23, p. 9, lines 2-3 and 9-11, p. 16, lines 7-12, and p. 20, lines 17-18; see also Figure 2, step 44, and Figure 3D, step 152); and

(b) enabling decentralized downloads of subscription-based content (Specification, p. 5, line 1, p. 9, lines 14-15, see also Figure 2, step 46) by

(i) allowing client nodes of the multiple client nodes to subscribe to the subscription-based content (Specification, p. 5, lines 2-3, p. 9, lines 16-17; see also Figure 3A, steps 100 and 102)

i) periodically sending the subscription-based content to each respective subscribing client node (Specification, p. 5, lines 3-5, p. 9, lines 17-19; see also Figure 3D, steps 140 and 148), and

(iii) charging a fee to providers of the subscription-based content for serving the subscription-based content (Specification, p. 5, lines 5-6, p. 9, lines 19-20; see also Figure 2, step 48).

Claim 9 recites a system for generating revenue in a peer-to-peer file delivery network (such as network 10, Figure 1A), the peer-to-peer file delivery network including at least one server node (such as server node 12, Figure 1A; see also Figure 1B) and multiple client nodes (such as client nodes 14, Figure 1A), the system comprising:

means for enabling peer-to-peer file sharing of content (Specification, p. 9, lines 1-2; see also Figure 2, step 42) whereby one client node initiates a download of a particular content item served from the server node or another client node (Specification, p. 4, lines 20-22, p. 9, lines 3-7), and wherein a fee is charged based on a quantity of content served related to the particular

content item (Specification, p. 4, lines 22-23, p. 9, lines 2-3 and 9-11, p. 16, lines 7-12, and p. 20, lines 17-18; see also Figure 2, step 44, and Figure 3D, step 152); and

means for enabling decentralized downloads of subscription-based content that client nodes of the multiple client nodes subscribe to in order to receive periodic updates (Specification, p. 5, lines 1-5, p. 9, lines 14-19, see also Figure 2, step 46, Figure 3D, steps 140 and 148), wherein a fee is charged to providers of subscription-based content for serving the subscription-based content to the client nodes (Specification, p. 5, lines 5-6, p. 9, lines 19-20; see also Figure 2, step 48).

The means for enabling peer-to-peer file sharing of content is a client node (such as client node 14 with a client application 22, see Specification, p. 8, lines 1-5; Figure 1A) and at least one server node (such as server node 12) with at least one database (Specification, p. 11, line 21 through p. 12, line 8; see also Figure 1B). The means for enabling decentralized downloads of subscription-based content is the server node.

Claim 17 recites a computer-readable medium containing program instructions for generating revenue in a peer-to-peer file delivery network (such as network 10, Figure 1A), the peer-to-peer file delivery network including at least one server node (such as server node 12, Figure 1A; see also Figure 1B) and multiple client nodes (such as client nodes 14, Figure 1A), the program instructions for:

(a) enabling peer-to-peer file sharing of content (Specification, p. 9, lines 1-2; see also Figure 2, step 42) by,

(i) initiating on one client node a download of a particular content item served from the server node or another client node (Specification, p. 4, lines 20-22, p. 9, lines 3-7), and

(ii) charging a fee based on a quantity of content served related to the particular content item (Specification, p. 4, lines 22-23, p. 9, lines 2-3 and 9-11, p. 16, lines 7-12, and p. 20, lines 17-18; see also Figure 2, step 44, and Figure 3D, step 152); and

(b) enabling decentralized downloads of subscription-based content by

(i) allowing client nodes of the multiple client nodes to subscribe to subscription-based content (Specification, p. 5, line 1, p. 9, lines 14-15, see also Figure 2, step 46),

(ii) periodically sending the subscription-based content to each respective subscribing client node (Specification, p. 5, lines 3-5, p. 9, lines 17-19; see also Figure 3D, steps 140 and 148), and

(iii) charging a fee to providers of the subscription-based content for serving the subscription-based content (Specification, p. 5, lines 5-6, p. 9, lines 19-20; see also Figure 2, step 48).

Claim 25 recites a method for providing subscription-based decentralized file downloads to client nodes (such as client nodes 14, Figure 1A) in a peer-to-peer public network (such as network 10, Figure 1A), each of the client nodes affiliated with a user account, the method comprising the steps of:

(a) receiving content files (such as files 20a and 20b, Figure 1B) from at least one content provider, the content including free subscription content files, fee-based subscription content files, and marketing content files (Specification, p. 19, lines 1-12);

(b) allowing the client nodes to subscribe to particular content files (Specification, p. 19, lines 1-4; Figure 3D, step 140);

(c) periodically delivering the particular content files to respective clients nodes that subscribed to the particular content files (Specification, p. 5, lines 5-6, p. 9, lines 17-19, p. 20, lines 1-6, Figure 3D, step 148);

(d) charging the at least one content provider a fee for delivering the content files to the client nodes over the peer-to-peer public network (Specification, p. 20, lines 17-18; Figure 3D, step 152);

(e) charging the at least one content provider a fee for the marketing content files based on a number of users that access the marketing content files once downloaded (Specification, p. 20, lines 18-20, Figure 3D, step 154); and

(f) charging user accounts of the client nodes that received fee-based subscription content files (Specification, p. 20, lines 20-21; Figure 3D, step 156).

Claim 26 recites a method for generating revenue in a peer-to-peer file delivery network (such as network 10, Figure 1A), the network including at least one server node (such as server node 12, Figure 1A; see also Figure 1B) and multiple client nodes (such as client nodes 14, Figure 1A), the method comprising the steps of:

(a) enabling peer-to-peer file sharing of content (Specification, p. 9, lines 1-2; see also Figure 2, step 42) by,

(i) initiating on one client node a download of a particular content item served from the at least one server node or another client node (Specification, p. 4, lines 20-22, p. 9, lines 3-7), and

(ii) charging a fee based on a quantity of content served related to the particular content item (Specification, p. 4, lines 22-23, p. 9, lines 2-3 and 9-11, p. 16, lines 7-12, and p. 20, lines 17-18; see also Figure 2, step 44, and Figure 3D, step 152);

(b) enabling decentralized downloads of subscription-based content by

(i) allowing client nodes of the multiple client nodes to subscribe to the subscription-based content (Specification, p. 5, line 1, p. 9, lines 14-15, see also Figure 2, step 46),

(ii) periodically sending the subscription-based content to each respective subscribing client node (Specification, p. 5, lines 3-5, p. 9, lines 17-19; see also Figure 3D, steps 140 and 148), and

(iii) charging a fee to providers of the subscription-based content for serving the subscription-based content (Specification, p. 5, lines 5-6, p. 9, lines 19-20; see also Figure 2, step 48);

(c) providing direct marketing (Figure 2, step 50) by

(i) sending marketing content to the client nodes from the at least one server node as well as from other client nodes (Specification, p. 10, lines 12-15), and

(ii) charging a fee to providers of the marketing content (Specification, p. 10, lines 18-19; Figure 2, step 52); and

(d) enabling client nodes to become affiliate servers that deliver content to other client nodes, and paying owners of the affiliate servers a percentage of the fee charged for serving files (Specification, p. 5, lines 10-14; Figure 2, steps 54 and 56).

Claim 27 recites a system for generating revenue in a peer-to-peer file delivery network (such as network 10, Figure 1A), the peer-to-peer file delivery network including at least one server node (such as server node 12, Figure 1A; see also Figure 1B) and multiple client nodes (such as client nodes 14, Figure 1A), the system comprising:

means for enabling peer-to-peer file sharing of content (Specification, p. 9, lines 1-2; see also Figure 2, step 42) whereby one client node initiates a download of a particular content item served from the at least one server node or another client node (Specification, p. 4, lines 20-22, p. 9, lines 3-7), and wherein a fee is charged based on a quantity of content served related to the particular content item (Specification, p. 4, lines 22-23, p. 9, lines 2-3 and 9-11, p. 16, lines 7-12, and p. 20, lines 17-18; see also Figure 2, step 44, and Figure 3D, step 152);

means for enabling decentralized downloads of subscription-based content that client nodes of the multiple client nodes subscribe to in order to receive periodic updates (Specification, p. 5, line 1-5, p. 9, lines 14-19, see also Figure 2, step 46, Figure 3D, steps 140 and 148), wherein a fee is charged to providers of the subscription-based content for serving the subscription-based content to the client nodes (Specification, p. 5, lines 5-6, p. 9, lines 19-20; see also Figure 2, step 48);

means for providing direct marketing to the client nodes such that marketing content is sent to the client nodes from the at least one server node as well as from other client nodes (Specification, p. 10, lines 12-15), and a fee is charged to providers of the marketing content (Specification, p. 10, lines 18-19); and

means for enabling client nodes to become affiliate servers that deliver content to other client nodes, such that owners of the affiliate servers are paid a percentage of the fee charged for serving files (Specification, p. 5, lines 10-14).

The means for enabling peer-to-peer file sharing of content is a client node (such as client node 14 with a client application 22, see Specification, p. 8, lines 1-5; Figure 1A) and at least one server node (such as server node 12) with at least one database (Specification, p. 11, line 21 through p. 12, line 8; see also Figure 1B). The means for enabling decentralized downloads of subscription-based content is the server node. The means for providing direct marketing is also the server node (Specification, p. 10, lines 12-19; Figure 1B). The means for enabling client nodes to become affiliate servers is the client application 22 on the client node 14 (specification, p. 5, lines 10-14, p. 8, lines 1-5).

Claim 28 recites a system for generating revenue in a peer-to-peer file delivery network (such as network 10, Figure 1A), comprising:

a server node (such as server node 12, Figure 1A; see also Figure 1B) adapted to:

allow a download by a client node (such as any of the client nodes 14, Figure 1A) (Specification, p. 4, lines 20-22, p. 9, lines 3-7), wherein a fee is charged based on a quantity of content served during the download (Specification, p. 4, lines 22-23, p. 9, lines 2-3 and 9-11, p. 16, lines 7-12, and p. 20, lines 17-18; see also Figure 2, step 44, and Figure 3D, step 152); and

enable downloads of subscription-based content by client nodes (Specification, p. 5, line 1-5, p. 9, lines 14-19, see also Figure 2, step 46, Figure 3D, steps 140 and 148), wherein a second fee is charged to providers of the subscription-based content for serving the subscription based content to the client nodes (Specification, p. 5, lines 5-6, p. 9, lines 19-20; see also Figure 2, step 48).

Claim 29 recites a server node (such as server node 12, Figure 1A; see also Figure 1B) comprising:

a network interface; and

a control system adapted to:

share content with a client node (such as any of the client nodes 14, Figure 1A) (Specification, p. 4, lines 20-22, p. 9, lines 3-7) and charge a fee based on a quantity of content shared with the client node (Specification, p. 4, lines 22-23, p. 9, lines 2-3 and 9-11, p. 16, lines 7-12, and p. 20, lines 17-18; see also Figure 2, step 44, and Figure 3D, step 152);

provide subscription-based content to which the client node may subscribe (Specification, p. 5, line 1-5, p. 9, lines 14-19, see also Figure 2, step 46, Figure 3D, steps 140 and 148), wherein a fee is charged to providers of the subscription-based content for providing the subscription-based content to the client node (Specification, p. 5, lines 5-6, p. 9, lines 19-20; see also Figure 2, step 48); and

provide direct marketing to the client node such that marketing content is provided to the client node and a fee is charged to providers of the marketing content (Specification, p. 10, lines 12-19; Figure 2, step 52); and

wherein the client node may become an affiliate server that delivers content to other client nodes such that an owner of the affiliate server is paid a percentage of a fee charged for content delivery (Specification, p. 5, lines 10-14, Figure 2, steps 54 and 56).

(6) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. Whether claims 1-6, 9-14, 17-22, 26, and 27 were properly rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0062290 A1 to Ricci (hereinafter "Ricci") in view of U.S. Patent No. 5,819,092 to Ferguson et al. (hereinafter "Ferguson").

B. Whether claims 7, 8, 15, 16, and 23-25 were properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Ricci in view of Ferguson and further in view of Admitted Prior Art (hereinafter "APA").

(7) ARGUMENT

A. Legal Standards for Establishing Obviousness

Section 103(a) of the Patent Act provides the statutory basis for an obviousness rejection and reads as follows:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Courts have interpreted 35 U.S.C. § 103(a) as a question of law based on underlying facts. As the Federal Circuit stated:

> Obviousness is ultimately a determination of law based on underlying determinations of fact. These underlying factual determinations include: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) the extent of any proffered objective indicia of nonobviousness.

Monarch Knitting Mach. Corp. v. Sulzer Morat GmBH, 45 USPQ2d 1977, 1981 (Fed. Cir. 1998) (internal citations omitted).

Once the scope of the prior art is ascertained, the content of the prior art must be properly combined. Initially, the Patent Office must show that there is a suggestion to combine the references. *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999). Even if the Patent Office is able to articulate and support a suggestion to combine the references, it is impermissible to pick and choose elements from the prior art while using the application as a template. *In re Fine*, 837

F.3d 1071 (Fed. Cir. 1988). To reconstruct the invention by such selective extraction constitutes impermissible hindsight. *In re Gorman*, 933 F.2d 982 (Fed. Cir. 1991). After the combination has been made, for a *prima facie* case of obviousness, the combination must still teach or fairly suggest all of the claim elements. *In re Royka*, 490 F.2d 981 (C.C.P.A. 1974); MPEP § 2143.03.

Whether an element is implicitly or explicitly taught by a reference or combination of references is open to interpretation. While the Patent Office is entitled to give claim terms their broadest reasonable interpretation, this interpretation is limited by a number of factors. First, the interpretation must be consistent with the specification. *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000); MPEP § 2111. Second, the broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, (Fed. Cir. 1999); MPEP § 2111. Finally, the interpretation must be reasonable. *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1369 (Fed. Cir. 2004); MPEP § 2111.01. This means that the words of the claim must be given their plain meaning unless Appellant has provided a clear definition in the specification. *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989).

If a claim element is missing after the combination is made, then the combination does not render obvious the claimed invention, and the claims are allowable. As stated by the Federal Circuit, "[if] the PTO fails to meet this burden, then the Appellant is entitled to the patent." *In re Glaug*, 283 F.3d 1335, 1338 (Fed. Cir. 2002).

B. Summary of the References

1. U.S. Patent Application Publication No. 2002/0062290 A1 to Ricci

Ricci is directed to a method for distributing and licensing digital media, and in particular, is concerned with using peer-to-peer networks without relinquishing control of the distribution from copyright holders (Ricci, paragraph 0020). In Ricci, digital media is licensed and shared across a network of peers (Ricci, Abstract). Advertisements related to the recipient's interests, demographics, and downloaded media are displayed. By displaying the ads, the recipients are charged for licensing the digital media (Ricci, Abstract). Instead of displaying the ads, traditional royalties can be charged without charging subscription fees (Ricci, paragraph 0032). The royalty paid by the downloading user to the content owner is the typical copyright royalty owned to the copyright owner or licensor, and is not based on the quantity of the content

(Ricci, paragraphs 0022, 0027, and 0031). Ricci may also use a royalty database, which includes the costs of licensing the digital media, the limits of the license (i.e., duration and number of uses), and relates the royalties to a recipients database to track which recipients have licensed which digital media (Ricci, paragraph 0053).

2. U.S. Patent No. 5,819,092 to Ferguson

Ferguson is directed to a visual editing system for creating commercial online computer services (Ferguson, Abstract). The visual editing system features a fee setting tool that allows the developer of the services to develop a fee structure for an online service. The fee structure can handle both fees levied against users and third party content providers (Ferguson, Abstract). A user may be levied fees for logging onto an online service, performing searches, or downloading information (Ferguson, col. 4, lines 55-57). Third party content providers can be levied fees for submitting advertisements or for executing a transaction with a user (Ferguson, col. 4, lines 58-60).

3. AAPA

The Specification of the present application reads in part: "As is well known in the art, in cost per click, the advertiser is charged a fee based on how many times users click on a displayed ad, while in cost per acquisition, the advertiser is based on how many new customers are acquired through the ads." (Specification, p. 8, lines 8-11).

C. Introduction

The present invention provides a method and system for generating revenue in a peer-to-peer file delivery network. The method and system include enabling peer-to-peer file sharing of content by initiating, on one client node, a download of a particular content item served from the server node or another client node, and then charging a fee based on a quantity of the content served (Specification, p. 4, lines 19-23). The independent claims 1, 9, 17, 25, and 26 all recite "charging a fee based on a quantity of content served. . ." or similar claim language. The "quantity of content" in the claim corresponds to the actual amount of data being served. As an example, the Applicant's Specification provides that "a sliding-fee scale may be used to charge

users based on the number of gigabytes, e.g., $30 for 1 gigabyte, $50 for 2 gigabytes, $90 for 5 gigabytes, and $150 for 10 gigabytes . . ." (Specification, page 16, lines 9-12).

The Patent Office has not shown where all the elements of the claim are shown with sufficient particularity to sustain an obviousness rejection. In particular, the references cited by the Patent Office fail to teach or suggest "charging a fee based on a quantity of content served," as claimed in the present invention. The Patent Office asserts that Ricci teaches this claim limitation. Appellant respectfully disagrees. Ricci discloses a method of licensing and distributing copyrighted digital media where a royalty is paid by the downloading user to the content owner. While Ricci indicates that the user downloading a file will pay the content owner, the fee is based on the appropriate royalty due the copyright owner, and is not based on the quantity of the content. Ricci also discloses a royalty database, which includes the costs of licensing the digital media and the limits of the license (i.e., duration, number of uses). The Patent Office incorrectly attempts to equate Ricci's disclosure of the number of uses in the license as charging a fee based on the quantity of content served. Ricci provides a technique to collect royalties for use of copyrighted material, but does not charge a fee based on the quantity of content served. The reason Ricci is not concerned about the quantity of content served is that royalties for copyrighted works are not based on the quantity of content, but are instead based on use of the content. As such, Ricci monitors use of the copyrighted content and thus does not charge fees based on the quantity of content served.

Since Ricci does not charge fees based on the quantity of content served and the other cited reference Ferguson does not cure the deficiencies of Ricci, the Patent Office has not shown where each and every element of the claimed invention is shown in the prior art with sufficient particularity to sustain an obviousness rejection. As such, the claims are not obvious, and therefore Appellant requests that the Board reverse the Examiner and instruct the Examiner to allow the claims for these reasons.

D. Claims 1-6, 9-14, 17-22, 26, and 27 Are Non-Obvious Because the Combination of Ricci and Ferguson Fails to Teach or Suggest "Charging a Fee Based on a Quantity of Content Served," as Required by the Claimed Invention

Claims 1-6, 9-14, 17-22, 26, and 27 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ricci in view of Ferguson et al. (hereinafter "Ferguson"). For the Patent Office to combine prior art references to create an obviousness rejection, the Patent Office must

do two things. First, the Patent Office must state the motivation to combine the references, and second, the Patent Office must support its asserted motivation to combine the prior art references with a clear and particular showing of actual evidence demonstrating that the asserted motivation exists. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). After the combination has been made, for a *prima facie* case of obviousness, the combination must still teach or fairly suggest all of the claim elements. *In re Royka*, 490 F.2d 981 (C.C.P.A. 1974); MPEP § 2143.03. Appellant appeals the rejection of claims 1-6, 9-14, 17-22, 26, and 27 because the combination of Ricci and Ferguson fails to teach each and every element of the claimed invention.

Claim 1 recites a method for generating revenue in a peer-to-peer file delivery network, the peer-to-peer file delivery network including at least one server node and multiple client nodes, the method comprising the steps of:

(a) enabling peer-to-peer file sharing of content by,

(i) initiating on one client node a download of a particular content item served from the server node or another client node, and

(ii) charging a fee based on a quantity of content served related to the particular content item; and

(b) enabling decentralized downloads of subscription-based content by

(i) allowing client nodes of the multiple client nodes to subscribe to the subscription-based content,

(ii) periodically sending the subscription-based content to each respective subscribing client node, and

(iii) charging a fee to providers of the subscription-based content for serving the subscription-based content.

Thus, as part of claim 1, enabling peer-to-peer file sharing of content is accomplished in part by charging a fee based on a quantity of content served related to the particular content item. The independent claims 1, 9, 17, and 25-27 (as well as claims 28 and 29) all recite "charging a fee based on a quantity of content served. . ." or similar claim language. The "quantity of content" corresponds to the actual amount of data being served. As an example, the Applicant's Specification provides that "a sliding-fee scale may be used to charge users based on the number of gigabytes, e.g., $30 for 1 gigabyte, $50 for 2 gigabytes, $90 for 5 gigabytes, and $150 for 10 gigabytes . . ." (Specification, page 16, lines 9-12). Although required by claims 1, 9, 17, and

25-29, neither Ricci nor Ferguson, alone or in combination, teach or suggest the claim limitation "charging a fee based on a quantity of content served."

The Patent Office originally asserts that the element is taught by Ricci in paragraphs 0022 and 0053 (Final Office Action mailed March 8, 2006, p. 6). Appellant respectfully disagrees. Paragraph 0022 states in full: "In accordance with a further object of the invention, the method insures that even an anonymous user downloading a file will pay the owner the appropriate royalty." While this passage indicates that the downloading user will pay the owner of the file, the fee is based on the appropriate royalty due the copyright owner. The fee is not based on the quantity of the content. Instead, the fee in Ricci is the copyright royalty payment owed to the copyright holder or licensor, and may be a traditional charge, or may be in the form of receiving advertisements (see paragraphs 0027 and 0031). Thus, paragraph 0022 of Ricci does not teach or suggest that the fee is based on the quantity of the content.

Likewise, paragraph 0053 of Ricci states in full: "The server also can include a royalty database. The royalty database includes the costs of licensing the digital media, the limits of the license (i.e., duration, number of uses) and relates the royalties to the recipients database to track which recipients have licensed which digital media." Again, this passage describes royalties for copyrighted works, but these royalties are not a function of the quantity of the content served. The Patent Office asserts that Ricci states that the royalties (fees) are based on the number of uses and that the number of uses is the same as the quantity of content served (Final Office Action mailed March 8, 2006, p. 4). This assertion is unfounded.

First, paragraph 0053 does not indicate that the fee charged is based on the number of uses. There is no mention of a fee at all in paragraph 0053. Paragraph 0053 merely states that the royalty database includes the costs of licensing the digital media and the limits of the license. The license limits include the duration of the license and the number of uses. Paragraph 0053 merely discloses that a database has as one piece of data the number of uses to which the licensee is entitled; the amount of the fee charged is not linked to the number of uses in the database. Since paragraph 0053 of Ricci is silent as to the amount of the royalty fees, it cannot teach or suggest charging a fee based on the quantity of content served. Simply disclosing the number of uses in a license is not equivalent to "charging a fee based on a quantity of content served," as required by the claimed invention. For this reason, the Patent Office's assertion that Ricci's mention of the number of uses teaches the claim limitation is incorrect.

Second, the claimed invention charges based on the quantity of the content served, not just how many times a file is served. Ricci does not teach or suggest anything about the quantity of the content served. As is clear from paragraphs 0022, 0027, and 0031, Ricci is focused on collecting the appropriate royalties for downloading files associated with copyrighted works. At best, Ricci provides a technique to collect royalties for each use of the copyrighted material, but Ricci fails to disclose a technique to measure the quantity of content served, and thus does not base the fee on the quantity of content served. The reason Ricci is not concerned about the quantity of content served is that royalties for copyrighted works are not based on the quantity of content, but are instead based on use of the content. As such, Ricci monitors use and is not concerned with the quantity of content served.

In contrast, Appellant's claimed invention contemplates charging users based on the quantity of the content served, i.e., the number of gigabytes. (Specification, page 16, lines 9-12). Different files will often be different sizes, and Ricci makes no differentiation between files of different size. However, use of two different sized files of similar content type would result in the same fees being charged in Ricci, whereas a user downloading two different sized files in the present invention would be charged two different amounts. Just because a file can be downloaded multiple times, does not indicate that quantity of content, or size, of the file is ever a factor. In short, charging based on the number of downloads is very different than charging based on the quantity of content served. At best, Ricci teaches only charging a royalty based on the number of downloads and fails to teach or suggest charging a fee based on the quantity of the content served.

In the Advisory Action, the Patent Office asserts that, taken in its broadest reasonable interpretation, "quantity" is equivalent to the number of uses. The Patent Office states "charging based on the number of uses is equivalent to charging based on the quantity of content served. In both cases an amount of content is delivered to a user, and in both cases the user is charged based on the amount of content that is delivered to the user." (Advisory Action mailed June 6, 2006, p. 2). Appellant respectfully disagrees.

First, the Patent Office's statement is incorrect on its face. In both Ricci and the present invention, an amount of content is delivered to as user. However, in Ricci, the user is not charged based on the amount of content, but rather on the number of uses of the copyrighted

material (See Ricci, paragraphs 0022, 0027, 0031, and 0053). Ricci is completely silent as to the amount of content served.

Second, Appellant respectfully submits that one of ordinary skill in the art would not consider "quantity of content" to equal "number of uses." Although the Patent Office is entitled to give claim terms their broadest reasonable interpretation, this interpretation is limited by a number of factors. First, the interpretation must be consistent with the specification. *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000); MPEP § 2111. Second, the broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, (Fed. Cir. 1999); MPEP § 2111. Finally, the interpretation must be reasonable. *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1369 (Fed. Cir. 2004); MPEP § 2111.01. This means that the words of the claim must be given their plain meaning unless Appellant has provided a clear definition in the specification. *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989). Construing "quantity of content" to be equivalent to "number of uses" is inconsistent with the specification, which indicates that "a sliding-fee scale may be used to charge users based on the number of gigabytes, e.g., $30 for 1 gigabyte, $50 for 2 gigabytes, $90 for 5 gigabytes, and $150 for 10 gigabytes . . ." (Specification, page 16, lines 9-12). It is also inconsistent with the interpretation that those skilled in the art would reach, especially after reading the above passage in the Specification. Finally, equating "quantity of content" to "number of uses" is unreasonable because it is inconsistent with the plain meaning of the word "quantity", which is a measurable amount. Thus, there is no reasonable interpretation that is consistent with the specification in which "quantity of content" would be equivalent to "number of uses."

To further demonstrate that "quantity of content" is not equivalent to "number of uses," consider the following example. In the traditional non-subscription royalty based system of Ricci, a user is charged a fee for each download of copyrighted material. This could be more costly if there were a large number of downloads, even if the files were relatively small. In the present invention, a large number of downloads of a relatively small file could be cheaper because of the quantity of content served. For example, if a user wanted to download ten digital files that were one gigabyte each, and the copyright royalty on each was $25, the user in Ricci's system would pay $250 ($25 per file for 10 libraries). In the present invention, assuming a sliding fee scale of $30 for 1 gigabyte, $50 for 2 gigabytes, $90 for 5 gigabytes, and $150 for 10

gigabytes, the user would be charged $150 for the 10 gigabytes that were downloaded (10 files of 1 gigabyte each and the cost of 10 gigabytes is $150). Thus, as seen in this example, the users would be charged different amounts for downloading the same content. Therefore, it is easy to see that being charged on the number of uses is not equivalent to being charged on the quantity of the content.

Thus, Ricci fails to teach or suggest the claim element of "charging a fee based on a quantity of content served," which is required by claims 1, 9, 17, and 26-29. The Patent Office points to nothing in Ferguson which cures the deficiencies of Ricci. Since the references individually do not teach or suggest the claim element, the combination of references cannot teach or suggest the claim element, and the Patent Office has not established obviousness.

Dependent claims 2-8, 10-16, and 18-24 further define the patentable subject matter of their respective independent claims and are therefore patentable for at least the same reasons as claims 1, 9 and 17.

Claims 26, 27, and 29, as well as dependent claims 3, 11, and 19 deserve special mention. These claims recite paying owners of the affiliate servers a percentage of the fee charged for serving the content. The Patent Office admits that Ricci does not teach this element, but asserts that it is taught by Ferguson, col. 9, lines 2-9 (Final Office Action mailed March 8, 2006, p. 7). While the cited passage of Ferguson does indicate that users of the system or content providers may be charged or paid, there is no indication that these users or content providers are affiliate servers as claimed in claims 3, 11,19, 26, 27, and 29. Paying the users as taught by Ferguson does not equal paying the owners of the affiliate servers as recited in the claims. The Patent Office states that the content providers of Ferguson are affiliate server owners, where users can download content from the content provider node (Final Office Action mailed March 8, 2006, p. 7). However, claims 3, 11,19, 26, 27, and 29 recite "enabling client nodes to become affiliate servers that deliver content to other client nodes, and paying owners of the affiliate servers a percentage of the fee charged for serving files." Ferguson does not teach or suggest enabling client nodes to become affiliate servers and then paying the owners of the affiliate servers a percentage of the fee. First, the content providers of Ferguson are traditional content providers, they are not client nodes that become affiliate servers. Second, Ferguson does not mention paying a **percentage** of the fee to the owners of the affiliate servers. Thus, Ferguson does not teach or suggest "enabling client nodes to become affiliate servers that deliver content to other

client nodes, and paying owners of the affiliate servers a percentage of the fee charged for serving files," as required by claims 3, 11, 19, 26, 27, and 29. Since Ferguson does not teach or suggest the element for which it is cited, and Ricci admittedly does not teach the element, the combination cannot teach or suggest the element. Therefore, the combination of Ricci and Ferguson does not establish obviousness, and claims 3, 11, 19, 26, 27, and 29 are allowable for this additional reason.

E. Claims 7, 8, 15, 16, and 23-25 Are Non-Obvious Because the Combination of Ricci, Ferguson, and Allegedly Admitted Prior Art Fail to Teach or Suggest Each and Every Element of Claims 7, 8, 15, 16, and 23-25

Claims 7, 8, 15, 16, and 23-25 were rejected under 35 U.S.C. § 103 as being unpatentable over Ricci in view of Ferguson and further in view of allegedly admitted prior art. Applicant respectfully traverses. The standards for establishing obviousness are set forth above. Claims 7-8 depend from claim 1 and contain all of the limitations of claim 1. Claims 15 and 16 depend from claim 9 depend from claim 1 and contain all of the limitations of claim 1. Claims 23 and 24 depend from claim 17 and contain all of the limitations of claim 1. Claim 25 was addressed above. Thus, all of these claims also contain the limitation "charging a fee based on a quantity of content served."

As discussed above, the combination of Ricci and Ferguson fails to teach or suggest "charging a fee based on a quantity of content served." The addition of the allegedly admitted prior art fails to cure the deficiencies of the combination of Ricci and Ferguson. Thus, claims 7, 8, 15, 16, and 23-25 are allowable.

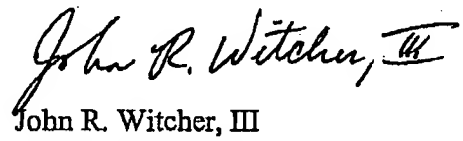
F. Conclusion

The Patent Office has not shown where all the elements of the claim are shown with sufficient particularity to sustain an obviousness rejection. In particular, the references cited by the Patent Office fail to teach or suggest "charging a fee based on a quantity of content served," as claimed in the present invention. Ricci provides a technique to collect royalties for use of copyrighted material, but does not charge a fee based on the quantity of content served. The reason Ricci is not concerned about the quantity of content served is that royalties for copyrighted works are not based on the quantity of content, but are instead based on use of the

content. As such, Ricci monitors use of the copyrighted content and thus does not charge fees based on the quantity of content served.

Since Ricci does not charge fees based on the quantity of content served and the other cited reference Ferguson does not cure the deficiencies of Ricci, the Patent Office has not shown where each and every element of the claimed invention is shown in the prior art with sufficient particularity to sustain an obviousness rejection. As such, the claims are not obvious, and therefore Appellant requests that the Board reverse the Examiner and instruct the Examiner to allow the claims for these reasons.

Respectfully submitted,
WITHROW & TERRANOVA, P.L.L.C.

By: 

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(8) APPENDIX

1. A method for generating revenue in a peer-to-peer file delivery network, the peer-to-peer file delivery network including at least one server node and multiple client nodes, the method comprising the steps of:

(a) enabling peer-to-peer file sharing of content by,

(i) initiating on one client node a download of a particular content item served from the server node or another client node, and

(ii) charging a fee based on a quantity of content served related to the particular content item; and

(b) enabling decentralized downloads of subscription-based content by

(i) allowing client nodes of the multiple client nodes to subscribe to the subscription-based content,

(ii) periodically sending the subscription-based content to each respective subscribing client node, and

(iii) charging a fee to providers of the subscription-based content for serving the subscription-based content.

2. The method of claim 1 further including the step of:

(c) providing direct marketing by

(i) sending marketing content to the client nodes from the server node as well as from other client nodes, and

(ii) charging a fee to providers of the marketing content.

3. The method of claim 1 further including the step of:

(d) enabling client nodes to become affiliate servers that deliver content to other client nodes, and paying owners of the affiliate servers a percentage of the fee charged for serving files.

4. The method of claim 1 wherein the content includes free content and fee-based content, step (a)(ii) further including the steps of:

(1) charging a fee to a provider of the free content for serving the free content, and

(2) charging a fee to a user of the initiating client node for the download of the fee-based content.

5. The method of claim 4 wherein the subscription-based content includes free content and fee-based content, step (b)(iii) further including the step of:

(1) charging a fee to users of the subscribing client nodes for receiving the fee-based content.

6. The method of claim 4 wherein the subscription-based content includes free content and fee-based content, step (b)(iii) further including the step of charging a fee to users of the subscribing client nodes for opening the fee-based content.

7. The method of claim 2 wherein step (c)(ii) further includes the step of: charging a fee to the provider of the marketing content based on a cost per click.

8. The method of claim 7 wherein step (c)(ii) further includes the step of: charging a fee to the provider of the marketing content based on a cost per acquisition.

9. A system for generating revenue in a peer-to-peer file delivery network, the peer-to-peer file delivery network including at least one server node and multiple client nodes, the system comprising:

means for enabling peer-to-peer file sharing of content whereby one client node initiates a download of a particular content item served from the server node or another client node, and wherein a fee is charged based on a quantity of content served related to the particular content item; and

means for enabling decentralized downloads of subscription-based content that client nodes of the multiple client nodes subscribe to in order to receive periodic updates, wherein a fee is charged to providers of subscription-based content for serving the subscription-based content to the client nodes.

10. The system of claim 9 further including means for providing direct marketing to client

nodes such that marketing content is sent to the client nodes from the server node as well as from other client nodes, and a fee is charged to providers of the marketing content.

11. The system of claim 9 further including means for enabling client nodes to become affiliate servers that deliver content to other client nodes, such that owners of the affiliate servers are paid a percentage of the fee charged for serving files.

12. The system of claim 9 wherein the content includes free content and fee-based content, and a provider of the free content is charged a fee for serving the free content, and a user of the initiating client node is charged a fee for download of the fee-based content.

13. The system of claim 12 wherein the subscription-based content includes second free content and second fee-based content, and wherein users of subscribing client nodes are charged a fee for receiving the second fee-based content.

14. The system of claim 12 wherein the subscription-based content includes second free content and second fee-based content, and wherein users of the subscribing client nodes are charged a fee for opening the second fee-based content.

15. The system of claim 10 further comprising means for charging a fee from a provider of the marketing content based on a cost per click.

16. The system of claim 15 further comprising means for charging a fee from the provider of the marketing content based on a cost per acquisition.

17. A computer-readable medium containing program instructions for generating revenue in a peer-to-peer file delivery network, the peer-to-peer file delivery network including at least one server node and multiple client nodes, the program instructions for:

(a) enabling peer-to-peer file sharing of content by,

(i) initiating on one client node a download of a particular content item served from the server node or another client node, and

(ii) charging a fee based on a quantity of content served related to the particular content item; and

(b) enabling decentralized downloads of subscription-based content by

(i) allowing client nodes of the multiple client nodes to subscribe to subscription-based content,

(ii) periodically sending the subscription-based content to each respective subscribing client node, and

(iii) charging a fee to providers of the subscription-based content for serving the subscription-based content.

18. The computer-readable medium of claim 17 further including the instruction of:

(c) providing direct marketing by

(i) sending marketing content to the client nodes from the server node as well as from other client nodes, and

(ii) charging a fee to providers of the marketing content.

19. The computer-readable medium of claim 17 further including the instruction of:

(d) enabling client nodes to become affiliate servers that deliver content to other client nodes, and paying owners of the affiliate servers a percentage of the fee charged for serving files.

20. The computer-readable medium of claim 17 wherein the content includes free content and fee-based content, instruction (a)(ii) further including the instructions of:

(1) charging a fee to a provider of the free content for serving the free content, and

(2) charging a fee to a user of an initiating client node for download of the fee-based content.

21. The computer-readable medium of claim 20 wherein the subscription-based content includes second free content and second fee-based content, instruction (b)(iii) further including the instruction of:

(1) charging a fee to users of the respective subscribing client node for receiving the second fee-based content.

22. The computer-readable medium of claim 20 wherein the subscription-based content includes second free content and second fee-based content, instruction (b)(iii) further including the instruction of charging a fee to users of the respective subscribing client nodes for opening the second fee-based content.

23. The computer-readable medium of claim 18 wherein instruction (c)(ii) further includes the instruction of:

charging a fee to the providers of the marketing content based on a cost per click.

24. The computer-readable medium of claim 23 wherein instruction (c)(ii) further includes the instruction of:

charging a fee to the providers of the marketing content based on a cost per acquisition.

25. A method for providing subscription-based decentralized file downloads to client nodes in a peer-to-peer public network, each of the client nodes affiliated with a user account, the method comprising the steps of:

(a) receiving content files from at least one content provider, the content including free subscription content files, fee-based subscription content files, and marketing content files;

(b) allowing the client nodes to subscribe to particular content files;

(c) periodically delivering the particular content files to respective clients nodes that subscribed to the particular content files;

(d) charging the at least one content provider a fee for delivering the content files to the client nodes over the peer-to-peer public network;

(e) charging the at least one content provider a fee for the marketing content files based on a number of users that access the marketing content files once downloaded; and

(f) charging user accounts of the client nodes that received fee-based subscription content files.

26. A method for generating revenue in a peer-to-peer file delivery network, the network including at least one server node and multiple client nodes, the method comprising the steps of:

(a) enabling peer-to-peer file sharing of content by,

(i) initiating on one client node a download of a particular content item served from the at least one server node or another client node, and

(ii) charging a fee based on a quantity of content served related to the particular content item;

(b) enabling decentralized downloads of subscription-based content by

(i) allowing client nodes of the multiple client nodes to subscribe to the subscription-based content,

(ii) periodically sending the subscription-based content to each respective subscribing client node, and

(iii) charging a fee to providers of the subscription-based content for serving the subscription-based content;

(c) providing direct marketing by

(i) sending marketing content to the client nodes from the at least one server node as well as from other client nodes, and

(ii) charging a fee to providers of the marketing content; and

(d) enabling client nodes to become affiliate servers that deliver content to other client nodes, and paying owners of the affiliate servers a percentage of the fee charged for serving files.

27. A system for generating revenue in a peer-to-peer file delivery network, the peer-to-peer file delivery network including at least one server node and multiple client nodes, the system comprising:

means for enabling peer-to-peer file sharing of content whereby one client node initiates a download of a particular content item served from the at least one server node or another client node, and wherein a fee is charged based on a quantity of content served related to the particular content item;

means for enabling decentralized downloads of subscription-based content that client nodes of the multiple client nodes subscribe to in order to receive periodic updates, wherein a fee is charged to providers of the subscription-based content for serving the subscription-based content to the client nodes;

means for providing direct marketing to the client nodes such that marketing content is sent to the client nodes from the at least one server node as well as from other client nodes, and a fee is charged to providers of the marketing content; and

means for enabling client nodes to become affiliate servers that deliver content to other client nodes, such that owners of the affiliate servers are paid a percentage of the fee charged for serving files.

28. A system for generating revenue in a peer-to-peer file delivery network, comprising:

a server node adapted to:

allow a download by a client node, wherein a fee is charged based on a quantity of content served during the download; and

enable downloads of subscription-based content by client nodes, wherein a second fee is charged to providers of the subscription-based content for serving the subscription based content to the client nodes.

29. A server node comprising:

a network interface; and

a control system adapted to:

share content with a client node and charge a fee based on a quantity of content shared with the client node;

provide subscription-based content to which the client node may subscribe, wherein a fee is charged to providers of the subscription-based content for providing the subscription-based content to the client node; and

provide direct marketing to the client node such that marketing content is provided to the client node and a fee is charged to providers of the marketing content; and

wherein the client node may become an affiliate server that delivers content to other client nodes such that an owner of the affiliate server is paid a percentage of a fee charged for content delivery.

(9) EVIDENCE APPENDIX

Appellant relies on no evidence, thus this appendix is not applicable.

(10) RELATED PROCEEDINGS APPENDIX

As there are no related proceedings, this appendix is not applicable.

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/963,812
Filing Date: September 26, 2001
Appellant(s): SCHLEICHER ET AL.

John R. Witcher, III
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 06 December 2006 appealing from the Office action mailed 08 March 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Ricci, United States Publication No. 2002/0062290 A1, 18 December 2001

5,819,092 Ferguson et al. 06 October 1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims **1-6, 9-14, 17-22, 26, and 27** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ricci, Pub. No. US2002/0062290 A1 in view of Ferguson et al., U.S. Patent No. 5,819,092.

As per **Claims 1, 9 and 17**, Ricci discloses a method for generating revenue in a peer-to-peer file delivery network, the network including at least one server node and multiple client nodes, the method comprising the steps of:

(a) enabling peer-to-peer file sharing of content by,

- (i) initiating on one client node a download of a particular content item served from the server node or another client node (0030-0033), and
- (ii) charging a fee based on a quantity of the content served (0022, 0053); and

(b) enabling decentralized downloads of subscription-based content by

- (i) allowing the client nodes to subscribe to one or more of the subscription-based content (0057, 0061),

- (ii) periodically sending the subscribed to subscription-based content to each the respective subscribing client nodes (0040).

Nonetheless, Ricci fails to disclose charging a fee to providers of the subscription-based content for serving the subscription-based content. However, Ferguson et al. teaches levying fees on content providers for transactions with the users (C. 4, lines 53-60). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Ricci and charge a fee to subscription-based content providers for transmitting their content as taught by Ferguson et al. because charging users and content providers a fee would greatly increase profitability of the file sharing service.

As per **Claims 2, 10, 18**, Ricci further discloses a method of providing direct marketing by sending marketing content to the client nodes from the server node as well as from other client nodes (0065, lines 1-8). Ricci fails to disclose charging a fee to providers of the marketing content. However, Ferguson et al. teaches charging a fee to providers of the marketing content (C. 14, lines 30-31). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Ricci to include charging marketing content providers a fee as taught by Ferguson et al. because charging marketing content providers a fee would greatly increase profitability of the file sharing service.

As per **Claims 3, 11, and 19**, Ricci further discloses a method enabling client nodes to become affiliate servers that deliver content to other client nodes (0030). Ricci fails to disclose paying owners of the affiliate servers a percentage of the fee charged for serving the files.

However, Ferguson et al. teaches paying the user of the service (C. 9, lines 2-9). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Ricci to include paying users of the affiliate servers a portion of the fee charged for serving the files as taught by Ferguson et al. because paying owners of the affiliate servers would increase retention of the affiliate server owners.

As per **Claims 4-6, 12-14, and 20-22**, Ricci further discloses a method including the steps of charging a fee from a user of the initiating client node for the download of the fee-based content (0022, 0053). Ricci fails to disclose charging a fee from a provider of the free content for serving the free content. However, Ferguson et al. teaches charging content providers a fee (C. 4, lines 53-60). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Ricci to include charging content providers a fee for serving the free content as taught by Ferguson et al. because charging content providers a fee would greatly increase profitability of the file sharing service.

As per **Claims 26, and 27**, Ricci discloses a system for generating revenue in a peer-to-peer file delivery network, the network including at least one server node and multiple client nodes, the method comprising the steps of:

- means for enabling peer-to-peer file sharing of content whereby one client node initiates a download of a particular content item served from the server node or another client node (0018), and
- wherein a fee is charged based on a quantity of the content served (0022, 0053);

- means for providing direct marketing to client nodes such that marketing content is send to the client nodes from the server node as well as from other client nodes (0065, lines 1-8),
- means for enabling client nodes to become affiliate servers that deliver content to other client nodes (0030),

Nonetheless, Ricci fails to disclose:

- means for enabling decentralized downloads of subscription-based content that the client nodes subscribe to in order to receive periodic updates, wherein a fee is charged to providers of the subscription-based content for serving the subscription-based content to the client nodes;
- owners of the affiliate servers are paid a percentage of the fee charged for serving the files.
- a fee is charged to providers of the marketing content.

However, Ferguson et al. teaches users of the system receive periodic updates; levying fees on content providers for transactions with the users; paying users of affiliate servers for serving the files, and finally teaches charging marketing content providers a fee (C. 15, lines 7-11; C. 4, lines 53-60; C. 14, lines 30-31; C. 9, lines 2-9). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Ricci and include providing periodic updates to users, levying fees on content providers, and to pay owners of affiliate servers for serving the files as taught by Ferguson et al. because charging content providers a fee would greatly increase profitability of the file sharing service. Also, paying

owners of affiliate servers because paying owners of the affiliate servers would increase retention of the affiliate server owners.

3. Claims **7, 8, 15, 16, 23-25** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ricci, Pub. No. US2002/0062290 A1 in view of Ferguson et al., U.S. Patent No. 5,819,092 as applied to claims **1, 9, and 17** above, and further in view of Applicants admission of the prior art.

As per **Claims 7, 15, and 23**, Ricci fails to disclose a method of charging a fee from the provider of the marketing content based on a cost per click. However, Applicant discloses that this feature is old and well known, see Specification, Page 11, lines 8-11. Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the Ricci and include charging a fee from the marketing content provider based on a cost per click as disclosed by Applicant. By Applicant's own admission, the feature of charging a fee from the provider of the marketing content based on a cost per click is admitted prior art.

As per **Claims 8, 16, and 24**, Ricci fails to disclose a method of charging a fee from the provider of the marketing content based on a cost per acquisition. However, Applicant discloses that this feature is old and well known, see Specification, Page 11, lines 8-11. Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the Ricci and include charging a fee from the marketing content provider based on a cost per acquisition as disclosed by Applicant. By Applicant's own admission, the feature of

charging a fee from the provider of the marketing content based on a cost per acquisition is admitted prior art.

As per **Claim 25**, Ricci fails to disclose a method for providing subscription-based decentralized file downloads to client nodes in a peer-to-peer public network, each of the client nodes affiliated with a user account, the method comprising the steps of:

- (b) allowing the client nodes to subscribe to one or more of the content files (0057, 0061);
- (c) periodically delivering the particular content files to the respective clients nodes that subscribed to the content files (0040);
- (f) charging the user accounts of the client nodes that received fee-based subscription content files (0022, 0053).

Nonetheless, Ricci fails to disclose:

- (a) receiving content files from at least one content provider, the content including free subscription content files, fee-based subscription content files, and marketing content files;
- (d) charging the content provider a fee for delivering the content files to the client nodes over the network.

However, Ferguson et al. teaches receiving content files from content providers; and also charging content providers a fee for serving the content files to the users (C. 4, lines 53-60). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Ricci and include receiving content files from content

providers and charging content providers a fee for serving the files as taught by Ferguson et al. because charging a variety of content providers a fee would greatly increase profitability of the file sharing service. Ricci and Ferguson et al. nonetheless fail to disclose charging the content provider a fee for the marketing content files based on a number of users that access the marketing content files once downloaded. However, Applicant discloses that this feature is old and well known, see Specification, Page 11, lines 8-11. Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the Ricci and include charging content provider a fee based on the number of users to access the content as disclosed by Applicant. By Applicant's own admission, the feature of charging a fee from the provider of the marketing content based on a cost per acquisition is admitted prior art.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims **1-27** are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims **16 and 17** of copending Application No. 09/814319 in view of Ferguson et al., U.S. Patent No. 5,819,092.

This is a provisional obviousness-type double patenting rejection. Although the conflicting claims are not identical, they are not patentably distinct from each other. Claims **16 and 17** of Application No. 09/814319 recite:

A peer-to-peer file delivery network, comprising:

- at least one server node;
- multiple client nodes coupled to the server node over the network, each of the client nodes running a client application, wherein the client application works and operates in conjunction with the server node to enable secure and reliable peer-to-peer file sharing between two client nodes by,

enable secure and reliable peer-to-peer file sharing between two client nodes by,

- generating account information for a user of each client node, including a digital certificate, in response to a registration process, wherein the digital certificate includes a private key and a public key,
- in response to a file being selected for publication on a first client node by a first user,
    - generating and associating a digital fingerprint with the file,
    - generating a bitstream ID for the file and including the bitstream ID in the fingerprint, and
    - using the user's private key to generate a digital signature from the

file and including the digital signature in the fingerprint.

adding an entry for the file to a search list of shared files on the server

- node and storing the fingerprint on the server,

- in response to a second client node selecting the file from the search list on the server node, automatically transferring the file from the first client node directly to the second client node, and

- authenticating the file by the second client node by generating a new bitstream ID, comparing the new bitstream ID to the bitstream ID in the fingerprint stored on the server, and using the user's public key to decrypt the digital signature to determine the authenticity and reliability of the file and publisher.

The network of claim 17 wherein the client application operates in conjunction with the server node to enable subscription-based decentralized file downloads to the client nodes by

- allowing the client nodes to subscribe with the server node to periodically receive copies of one of the files,
- when providing a current subscribing client node with the file, locating the closest client node containing the file, and
- transferring the file from the closest node directly to the current subscribing node, thereby efficiently utilizing bandwidth.

Claims 16 and 17 of Application No. 09/814319 differs since it further recites additional claim limitations including generating account information for a user of each client node, including a digital certificate; authenticating the file by the second client node by generating a new bitstream

ID; and allowing client nodes to subscribe with the server node to periodically receive copies of one of the files. However, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify claims **16 and 17** of Application No. 09/814319 by removing the limitations directed to generating account information, authenticating a file using a bitstream, and allowing client nodes to subscribe with the server node resulting generally in the claims of the present application since the claims of the present application and the claims recited in Application No. 09/814319 actually perform a similar function. It is well established that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before.

Also, claims **16 and 17** of Application No. 09/814319 differ since they fail to recite a method for charging a fee to providers and users of the subscription-based content, either for serving the subscription-based content to the users or for receiving the content. Ferguson et al. teaches a method for levying fees against both users and content providers in an online system (C. 4, lines 53-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify claims **16 and 17** of Application No. 09/814319 and include the method of charging a fee to providers and users of the subscription-based content as taught by Ferguson et al. because charging users and content providers a fee would greatly increase profitability for the service.

(10) Response to Argument

First Issue

Regarding the Appellant's argument that the Patent Office has failed to establish a *prima facie* case of obviousness, the Examiner asserts that the combination of references, i.e. Ricci in view of Ferguson et al., is proper. In this case, one of ordinary skill in the art would have been led to combine Ricci and Ferguson et al. in view of the fact that both references are directed to providing on-line content to users. Also, Ricci and Ferguson et al. are both related to charging users fees for downloading the content. For instance, Ricci discloses a method for distributing and licensing digital media across a network of peers (abstract). Ricci attempts to overcome the difficulties faced by content owners whose digital content was being downloaded in peer-to-peer networks without compensating the content owners by implementing a system that allows peer-to-peer file sharing while at the same time charging users for the content provided in order to compensate content owners. Ricci discloses users downloading a file will pay the appropriate royalty. Paying the appropriate royalty recoups the costs to the content provider for distributing the files, who must then compensate the content creator for use of their content. Furthermore, Ferguson et al. teaches a fee setting tool that allows the developer to develop a fee structure for an online service, e.g. downloading content (abstract). Ferguson et al. further teaches a third party content provider (i.e. content owner) can be paid when that third party content provider supplies valuable information desired by the users of the online services. The action of paying the content providers for supplying the information is in essence compensating the content providers for distributing the files. We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one

of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved. *In re Dembiczak*, 50 USPQ2d 1614. Therefore, the "motivation-suggestion-teaching" test asks not merely what the references disclose, but whether a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in the prior art, and motivated by the general problem facing the inventor, would have been led to make the combination recited in the claims. *In re Kahn* 78 USPQ2d 1329 (CAFC 2006). Thus, someone of ordinary skill in the art would be led to combine Ricci and Ferguson et al.

Second Issue

Examiner notes that the failure to address the Appellant's claims 28 and 29, which were added by amendment in response to the initial non-final office action, was inadvertent. Despite the Examiner's unintentional oversight of claims 28 and 29, Examiner notes that the Appellant discloses that claims 28 and 29 correspond to claims 9 and 27 but without the means plus function language. Therefore, if not for the unintentional oversight of the claims, Examiner would have mirrored the rejections of claims 28 and 29 similarly to the rejections of claims 9 and 27.

Third Issue

Appellant argues that neither Ricci nor Ferguson et al., alone or in combination, teach or suggest the claim limitation "charging a fee based on a quantity of content served." The Appellant notes that independent claims 1, 9, 17, and 25-27, as well as claims 28 and 29, all recite "charging a fee based on a quantity of content served" or similar language. The Appellant

further recites "the quantity of content corresponds to the actual amount of data being served." As an example, the Applicant's Specification provides that "a sliding-fee scale.....,e.g. $30 for 1 gigabyte...." Examiner notes that the Appellant's specification actually recites "For example, a sliding-fee scale..." It is well established that *examples* in a specification do not further define a claim limitation, and therefore the Appellant's definition for the claim limitation "charging a fee based on a quantity of content served" is not based on the example given in the specification.

Recent decisions have indicated that if an inventor is relying on a special meaning for terms appearing in the claims, then the special meaning must be clearly written in the specification. "Although an applicant may be his own lexicographer... nothing in the specification defines the phrase 'quantity of content served' differently from its ordinary meaning", see *In Re Thrift*, 63 USPQ2d 2002, 2006 (Fed. Cir. 2002). "One purpose for examining the specification is to determine if the patentee has limited the scope of the claims.' ...For example, an inventor may choose to be his own lexicographer if he defines the specific terms used to describe the invention 'with reasonable clarity, deliberateness, and precision', see *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 63 USPQ2d 1374, 1381 (Fed. Cir. 2002) and *In re Paulsen*, 31 USPQ2d 1671, 1674-75 (Fed. Cir. 1994). Examiner submits that the "number of uses" disclosed by Ricci meets the definition for "quantity of content served" described by the Appellant.

Appellant argues, "the fee in Ricci is the copyright royalty payment". Examiner asserts that a fee owed to a copyright owner wherein the user is charged based on the number of uses (e.g. downloads, duration, etc.) is equivalent to the Appellant's "quantity of content." Further, the Appellant argues that "the amount of the fee charged is not linked to the number of uses in

the database." However, Examiner notes that a user purchasing a license to use the digital media would be charged based on the number of licenses that user purchases and therefore would be charged on the "quantity of content served." The Examiner notes the broadest reasonable interpretation of "number of uses" would include "quantity of content served." Further, Examiner notes during patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification," moreover the Examiner notes claims of issued patents are interpreted in light of the specification, but during examination, prosecution history, prior art, and other claims, must be interpreted as broadly as their terms reasonably allow (MPEP 2111). Thus, the Examiner interprets Ricci to disclose quantity of content served.

Examiner notes that Appellant's argument, "Different files will often be different sizes, and Ricci makes no differentiation between files of different size", is inconsistent with the Appellant's claim limitations. Appellant is attempting to read in a definition into the claim limitations which lacks support in the specification. Further, the claim limitations are broader than the definition that the Appellant is attempting to argue. Appellant's specification fails to define the claim limitation in a manner that one of ordinary skill in the art would read "quantity of content served" differently than the Examiner has already done.

Furthermore, Examiner notes that Ferguson et al. further teaches charging a user based on the quantity of content served. Ferguson et al. teaches, "The ability to set fees to be paid by the user *for an amount of data accessed*, the time spent "logged on" to the online service, or the purchase of particular merchandise..." Ferguson et al. thus teaches that it is old and well known in the art to charge a user based a quantity (i.e. amount) of content (data) served (accessed).

Fourth Issue

Appellant argues with respect to claims 3, 11, 19, 26, 27 and 29 that Ferguson et al. fails to teach paying owners of the affiliate servers a percentage of the fee charged for serving the content. However, Examiner notes that the Ferguson reference was cited for teaching charging or paying users or content providers (C. 9, lines 2-9). Ricci was cited for disclosing, "transfers of the digital media can be made on the bandwidth of the peers rather than the originator, ie. enabling client nodes to become affiliate servers that deliver content to other client nodes (0030). Ferguson et al.'s teaching of paying the content provider or user for the digital media transaction in combination with Ricci's disclosure of peer-to-peer file sharing teaches the Appellant's invention. Paying users who allow other client nodes to download files from their system is a basic economical decision wherein a resource supplier is reimbursed for their resource.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Fadey S. Jabr
Examiner
Art Unit 3628

Conferees:

John W. Hayes

Vincent Millin

JOHN W. HAYES
SUPERVISORY PATENT EXAMINER

Electronic Acknowledgement Receipt

EFS ID:	1710780
Application Number:	09963812
International Application Number:	
Confirmation Number:	1207
Title of Invention:	DOCKETED MK 4/24/07 Method and system for generating revenue in a peer-to-peer file delivery network
First Named Inventor/Applicant Name:	Jorg Gregor Schleicher
Customer Number:	27820
Filer:	Benjamin Withrow/Michelle Heymann
Filer Authorized By:	Benjamin Withrow
Attorney Docket Number:	1104-032
Receipt Date:	24-APR-2007
Filing Date:	26-SEP-2001
Time Stamp:	14:25:08
Application Type:	Utility

Payment information:

Submitted with Payment	no

File Listing:

Document Number	Document Description	File Name	File Size(Bytes)	Multi Part /.zip	Pages (if appl.)
1	Reply Brief Filed	Reply_Brief_4-24-07.pdf	201658	no	4
Warnings:					

Information:	
Total Files Size (in bytes):	201658

This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

New Applications Under 35 U.S.C. 111

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Jorg G. Schleicher et al.
Serial No. 09/963,812
Filed: 09/26/2001
Examiner: Fadey S. Jabr
Art Unit: 3628
For: **METHOD AND SYSTEM FOR GENERATING REVENUE IN A PEER-TO-PEER FILE DELIVERY NETWORK**

Mail Stop Appeal Brief – Patents
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

A **REPLY BRIEF** is filed herewith in response to the Examiner's Answer mailed February 27, 2007. If any fees are required in association with this Reply Brief, the Director is hereby authorized to charge them to Deposit Account 50-1732, and consider this a petition therefor.

REPLY BRIEF

A. Introduction

In addition to the reasons detailed in the Appeal Brief filed on December 6, 2006, the Appellants respectfully submit that claims 1-27 are patentable over *Ricci* in view of *Ferguson* and further in view of the *Appellants' Related Art* for the reasons set forth below. In particular, none of the references, either alone or in combination, discloses or suggests all the features recited in claims 1-27. As such, these claims are patentable.

B. Argument

Claims 1-6, 9-14, 17-22, 26, and 27 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Ricci* in view of *Ferguson*. The Appellants traverse the rejection.

According to Chapter 2143.03 of the M.P.E.P., in order to "establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." The Appellants submit that neither *Ricci* nor *Ferguson*, either alone or in combination, discloses or suggests all the features recited in claims 1-6, 9-14, 17-22, 26, and 27. More specifically, claim 1 recites a method for generating revenue in a peer-to-peer file delivery network comprising, among other features, "periodically sending the subscription-based content to each respective subscribing client node." Claims 17 and 26 include similar features. The Appellants submit that none of the references, either alone or in combination, discloses or suggests periodically sending subscription-based content to a subscribing client node. In maintaining the rejection, the Patent Office asserts that *Ricci* discloses this feature at paragraph **[0040]**.[1] The Appellants respectfully disagree. At most, the cited portion of *Ricci* discloses that during the transfer of digital media, a network acts like a peer-to-peer network without requiring a central server.[2] However, no mention is made or suggested of periodically sending subscription-based content to a subscribing client node. Furthermore, the Appellants have reviewed the remainder of the reference and submit that nowhere does *Ricci* disclose or suggest this feature. Likewise, the Appellants have reviewed *Ferguson* and submit that *Ferguson* does not disclose or suggest periodically sending subscription-based content to a subscribing client node. Accordingly, for at least this reason, claims 1, 17, and 26 are patentable over the cited

[1] *See* Final Office Action mailed March 8, 2006, page 6.
[2] *See Ricci*, paragraph **[0040]**.

references. Similarly, claims 2-6 and 18-22, which ultimately depend from claims 1 or 17, respectively, are patentable for at least the same reason along with the novel features recited therein.

Claim 9 recites a system for generating revenue in a peer-to-peer file delivery network comprising, among other features, "means for enabling decentralized downloads of subscription-based content that client nodes of the multiple client nodes subscribe to in order to receive periodic updates." Claim 27 includes similar features. The Appellants respectfully submit that none of the references, either alone or in combination, discloses or suggests a means for enabling downloads of subscription-based content in order to receive periodic updates. As detailed above, none of the references, either alone or in combination, discloses or suggests periodically sending subscription based content to a subscribing client node. Therefore, it follows that neither reference, either alone or in combination, can disclose or suggest receiving periodic updates nor a means for enabling downloads of subscription-based content in order to receive periodic updates. As such, claims 9 and 27 are patentable over the cited references. Similarly, claims 10-14, which ultimately depend from claim 9, are patentable for at least the same reasons along with the novel features recited therein.

In addition, claims 7, 8, 15, 16, and 23-25 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Ricci* in view of *Ferguson* in further view of the *Appellants' Related Art*. The Appellants traverse the rejection.

Claim 25 recites a method for providing subscription-based decentralized file downloads to client nodes in a peer-to-peer public network comprising, among other features, "periodically delivering the particular content files to respective clients nodes that subscribed to the particular content files." As detailed above, neither *Ricci* nor *Ferguson*, either alone or in combination, discloses or suggests periodically delivering content files to clients that subscribed to the particular client files. In addition, the *Appellants' Related Art* does not disclose or suggest this feature. Accordingly, claim 25 is patentable over the cited references.

Regarding claims 7, 8, 15, 16, 23, and 24, as detailed above, claims 1, 9, and 17, the base claims from which claims 7, 8, 15, 16, 23, and 24 ultimately depend, are patentable over *Ricci* and *Ferguson*. Moreover, as mentioned above, the *Appellants' Related Art* does not overcome the previously noted shortcomings of both *Ricci* and *Ferguson*. Therefore, claims 7, 8, 15, 16, and 23-25 are patentable over the cited references.

C. Conclusion

As detailed above, none of the cited references, either alone or in combination, discloses or suggests periodically sending or receiving subscription-based content to a subscribing client node. Therefore, claims 1-6, 9-14, 17-22, 26, and 27 are patentable over *Ricci* in view of *Ferguson* and claims 7, 8, 15, 16, and 23-25 are patentable over *Ricci* in view of *Ferguson* and further in view of the *Appellants' Related Art*.

Respectfully submitted,
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Date: April 24, 2007
Attorney Docket: 1104-032

1164-032

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JORG GREGOR SCHIEICHER
AND CHRISTOPHER ALLIN KITZE

Application No. 09/963,812

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received electronically at the Board of Patent Appeals and Interferences on July 21, 2007. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matter requiring attention prior to docketing is identified below.

EXAMINER'S ANSWER

STATUS OF CLAIMS

On February 27, 2007, an Examiner's Answer was entered to the record. On page 2, the examiner stated that "[t]he statement of the status of claims contained in the brief is correct." However, on January 6, 2006, the appellants filed an amendment

adding claims 28 and 29. The Final Rejection mailed March 8, 2006 indicates that only claims 1-27 were rejected. Clarification of the status of claims 28 and 29 is required. The Examiner shall notify the appellants, in writing whether or not claims 28 and 29 will be added for purposes of the appeal.

Accordingly, it is

ORDERED that the application is returned to the Examiner:

1) for clarification of the status of claims 28 and 29; and

2) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

By: Patrick J. Nolan

PATRICK J. NOLAN
Deputy Chief Appeals Administrator
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PJN/dal

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UNITED STATES PATENT AND TRADEMARK OFFICE

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EXAMINER	
JABR, FADEY S	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/963,812
Filing Date: September 26, 2001
Appellant(s): SCHLEICHER ET AL.

John R. Witcher, III
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 06 December 2006 appealing from the Office action mailed 08 March 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

NEW GROUND(S) OF REJECTION

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows: Claims **28-29** correspond to claims **9** and **27** but without the means plus function language, as stated by the Appellant. The claims were inadvertently not entered. Therefore, Claims **28-29** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ricci, Pub. No. US2002/0062290 A1 in view of Ferguson et al., U.S. Patent No. 5,819,092.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Ricci, United States Publication No. 2002/0062290 A1, 18 December 2001

5,819,092 Ferguson et al. 06 October 1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims **1-6, 9-14, 17-22 and 26-29** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ricci, Pub. No. US2002/0062290 A1 in view of Ferguson et al., U.S. Patent No. 5,819,092.

As per **Claims 1, 9, 17 and 29**, Ricci discloses a method for generating revenue in a peer-to-peer file delivery network, the network including at least one server node and multiple client nodes, the method comprising the steps of:

(a) enabling peer-to-peer file sharing of content by,

- (i) initiating on one client node a download of a particular content item served from the server node or another client node (0030-0033), and
- (ii) charging a fee based on a quantity of the content served (0022, 0053); and

(b) enabling decentralized downloads of subscription-based content by

- (i) allowing the client nodes to subscribe to one or more of the subscription-based content (0057, 0061),
- (ii) periodically sending the subscribed to subscription-based content to each the respective subscribing client nodes (0040).

Nonetheless, Ricci fails to disclose charging a fee to providers of the subscription-based content for serving the subscription-based content. However, Ferguson et al. teaches levying fees on content providers for transactions with the users (C. 4, lines 53-60). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Ricci and charge a fee to subscription-based content providers for transmitting their content as taught by Ferguson et al. because charging users and content providers a fee would greatly increase profitability of the file sharing service.

As per **Claims 2, 10, 18**, Ricci further discloses a method of providing direct marketing by sending marketing content to the client nodes from the server node as well as from other client nodes (0065, lines 1-8). Ricci fails to disclose charging a fee to providers of the marketing content. However, Ferguson et al. teaches charging a fee to providers of the marketing content (C. 14, lines 30-31). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Ricci to include charging marketing

content providers a fee as taught by Ferguson et al. because charging marketing content providers a fee would greatly increase profitability of the file sharing service.

As per **Claims 3, 11, and 19**, Ricci further discloses a method enabling client nodes to become affiliate servers that deliver content to other client nodes (0030). Ricci fails to disclose paying owners of the affiliate servers a percentage of the fee charged for serving the files. However, Ferguson et al. teaches paying the user of the service (C. 9, lines 2-9). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Ricci to include paying users of the affiliate servers a portion of the fee charged for serving the files as taught by Ferguson et al. because paying owners of the affiliate servers would increase retention of the affiliate server owners.

As per **Claims 4-6, 12-14, and 20-22**, Ricci further discloses a method including the steps of charging a fee from a user of the initiating client node for the download of the fee-based content (0022, 0053). Ricci fails to disclose charging a fee from a provider of the free content for serving the free content. However, Ferguson et al. teaches charging content providers a fee (C. 4, lines 53-60). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Ricci to include charging content providers a fee for serving the free content as taught by Ferguson et al. because charging content providers a fee would greatly increase profitability of the file sharing service.

As per **Claims 26-28**, Ricci discloses a system for generating revenue in a peer-to-peer file delivery network, the network including at least one server node and multiple client nodes, the method comprising the steps of:

- means for enabling peer-to-peer file sharing of content whereby one client node initiates a download of a particular content item served from the server node or another client node (0018), and
- wherein a fee is charged based on a quantity of the content served (0022, 0053);
- means for providing direct marketing to client nodes such that marketing content is send to the client nodes from the server node as well as from other client nodes (0065, lines 1-8),
- means for enabling client nodes to become affiliate servers that deliver content to other client nodes (0030),

Nonetheless, Ricci fails to disclose:

- means for enabling decentralized downloads of subscription-based content that the client nodes subscribe to in order to receive periodic updates, wherein a fee is charged to providers of the subscription-based content for serving the subscription-based content to the client nodes;
- owners of the affiliate servers are paid a percentage of the fee charged for serving the files.
- a fee is charged to providers of the marketing content.

However, Ferguson et al. teaches users of the system receive periodic updates; levying fees on content providers for transactions with the users; paying users of affiliate servers for serving the

files, and finally teaches charging marketing content providers a fee (C. 15, lines 7-11; C. 4, lines 53-60; C. 14, lines 30-31; C. 9, lines 2-9). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Ricci and include providing periodic updates to users, levying fees on content providers, and to pay owners of affiliate servers for serving the files as taught by Ferguson et al. because charging content providers a fee would greatly increase profitability of the file sharing service. Also, paying owners of affiliate servers because paying owners of the affiliate servers would increase retention of the affiliate server owners.

3. Claims **7, 8, 15, 16, 23-25** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ricci, Pub. No. US2002/0062290 A1 in view of Ferguson et al., U.S. Patent No. 5,819,092 as applied to claims **1, 9, 17 and 29** above, and further in view of Applicants admission of the prior art.

As per **Claims 7, 15, and 23**, Ricci fails to disclose a method of charging a fee from the provider of the marketing content based on a cost per click. However, Applicant discloses that this feature is old and well known, see Specification, Page 11, lines 8-11. Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the Ricci and include charging a fee from the marketing content provider based on a cost per click as disclosed by Applicant. By Applicant's own admission, the feature of charging a fee from the provider of the marketing content based on a cost per click is admitted prior art.

As per **Claims 8, 16, and 24**, Ricci fails to disclose a method of charging a fee from the provider of the marketing content based on a cost per acquisition. However, Applicant discloses that this feature is old and well known, see Specification, Page 11, lines 8-11. Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the Ricci and include charging a fee from the marketing content provider based on a cost per acquisition as disclosed by Applicant. By Applicant's own admission, the feature of charging a fee from the provider of the marketing content based on a cost per acquisition is admitted prior art.

As per **Claim 25**, Ricci fails to disclose a method for providing subscription-based decentralized file downloads to client nodes in a peer-to-peer public network, each of the client nodes affiliated with a user account, the method comprising the steps of:

- (b) allowing the client nodes to subscribe to one or more of the content files (0057, 0061);
- (c) periodically delivering the particular content files to the respective clients nodes that subscribed to the content files (0040);
- (f) charging the user accounts of the client nodes that received fee-based subscription content files (0022, 0053).

Nonetheless, Ricci fails to disclose:

- (a) receiving content files from at least one content provider, the content including free subscription content files, fee-based subscription content files, and marketing content files;

- (d) charging the content provider a fee for delivering the content files to the client nodes over the network.

However, Ferguson et al. teaches receiving content files from content providers; and also charging content providers a fee for serving the content files to the users (C. 4, lines 53-60). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Ricci and include receiving content files from content providers and charging content providers a fee for serving the files as taught by Ferguson et al. because charging a variety of content providers a fee would greatly increase profitability of the file sharing service. Ricci and Ferguson et al. nonetheless fail to disclose charging the content provider a fee for the marketing content files based on a number of users that access the marketing content files once downloaded. However, Applicant discloses that this feature is old and well known, see Specification, Page 11, lines 8-11. Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the Ricci and include charging content provider a fee based on the number of users to access the content as disclosed by Applicant. By Applicant's own admission, the feature of charging a fee from the provider of the marketing content based on a cost per acquisition is admitted prior art.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims **1-27** are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims **16 and 17** of copending Application No. 09/814319 in view of Ferguson et al., U.S. Patent No. 5,819,092.

This is a provisional obviousness-type double patenting rejection.

Although the conflicting claims are not identical, they are not patentably distinct from each other. Claims **16 and 17** of Application No. 09/814319 recite:

A peer-to-peer file delivery network, comprising:

- at least one server node;
- multiple client nodes coupled to the server node over the network, each of the client nodes running a client application, wherein the client application works and operates in conjunction with the server node to enable secure and reliable peer-to-peer file sharing between two client nodes by,

enable secure and reliable peer-to-peer file sharing between two client nodes by,

- generating account information for a user of each client node, including a digital certificate, in response to a registration process, wherein the digital certificate includes a private key and a public key,
- in response to a file being selected for publication on a first client node by a first user,

- generating and associating a digital fingerprint with the file,

- generating a bitstream ID for the file and including the bitstream ID in the fingerprint, and

- using the user's private key to generate a digital signature from the file and including the digital signature in the fingerprint.

adding an entry for the file to a search list of shared files on the server node and storing the fingerprint on the server,

- in response to a second client node selecting the file from the search list on the server node, automatically transferring the file from the first client node directly to the second client node, and

- authenticating the file by the second client node by generating a new bitstream ID, comparing the new bitstream ID to the bitstream ID in the fingerprint stored on the server, and using the user's public key to decrypt the digital signature to determine the authenticity and reliability of the file and publisher.

The network of claim 17 wherein the client application operates in conjunction with the server node to enable subscription-based decentralized file downloads to the client nodes by

- allowing the client nodes to subscribe with the server node to periodically receive copies of one of the files,
- when providing a current subscribing client node with the file, locating the closest client node containing the file, and
- transferring the file from the closest node directly to the current subscribing node,

thereby efficiently utilizing bandwidth.

Claims **16 and 17** of Application No. 09/814319 differs since it further recites additional claim limitations including generating account information for a user of each client node, including a digital certificate; authenticating the file by the second client node by generating a new bitstream ID; and allowing client nodes to subscribe with the server node to periodically receive copies of one of the files. However, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify claims **16 and 17** of Application No. 09/814319 by removing the limitations directed to generating account information, authenticating a file using a bitstream, and allowing client nodes to subscribe with the server node resulting generally in the claims of the present application since the claims of the present application and the claims recited in Application No. 09/814319 actually perform a similar function. It is well established that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before.

Also, claims **16 and 17** of Application No. 09/814319 differ since they fail to recite a method for charging a fee to providers and users of the subscription-based content, either for serving the subscription-based content to the users or for receiving the content. Ferguson et al. teaches a method for levying fees against both users and content providers in an online system (C. 4, lines 53-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify claims **16 and 17** of Application No. 09/814319 and include the method of charging a fee to providers and users of the subscription-based content as taught by Ferguson et al. because charging users and content providers a fee would greatly increase profitability for the service.

(10) Response to Argument

First Issue

Regarding the Appellant's argument that the Patent Office has failed to establish a *prima facie* case of obviousness, the Examiner asserts that the combination of references, i.e. Ricci in view of Ferguson et al., is proper. In this case, one of ordinary skill in the art would have been led to combine Ricci and Ferguson et al. in view of the fact that both references are directed to providing on-line content to users. Also, Ricci and Ferguson et al. are both related to charging users fees for downloading the content. For instance, Ricci discloses a method for distributing and licensing digital media across a network of peers (abstract). Ricci attempts to overcome the difficulties faced by content owners whose digital content was being downloaded in peer-to-peer networks without compensating the content owners by implementing a system that allows peer-to-peer file sharing while at the same time charging users for the content provided in order to compensate content owners. Ricci discloses users downloading a file will pay the appropriate royalty. Paying the appropriate royalty recoups the costs to the content provider for distributing the files, who must then compensate the content creator for use of their content. Furthermore, Ferguson et al. teaches a fee setting tool that allows the developer to develop a fee structure for an online service, e.g. downloading content (abstract). Ferguson et al. further teaches a third party content provider (i.e. content owner) can be paid when that third party content provider supplies valuable information desired by the users of the online services. The action of paying the content providers for supplying the information is in essence compensating the content providers for distributing the files. We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one

of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved. *In re Dembiczak*, 50 USPQ2d 1614. Therefore, the "motivation-suggestion-teaching" test asks not merely what the references disclose, but whether a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in the prior art, and motivated by the general problem facing the inventor, would have been led to make the combination recited in the claims. *In re Kahn* 78 USPQ2d 1329 (CAFC 2006). Thus, someone of ordinary skill in the art would be led to combine Ricci and Ferguson et al.

Second Issue

Examiner notes that the failure to address the Appellant's claims 28 and 29, which were added by amendment in response to the initial non-final office action, was inadvertent. Despite the Examiner's unintentional oversight of claims 28 and 29, Examiner notes that the Appellant discloses that claims 28 and 29 correspond to claims 9 and 27 but without the means plus function language. Therefore, if not for the unintentional oversight of the claims, Examiner would have mirrored the rejections of claims 28 and 29 similarly to the rejections of claims 9 and 27, hence the New Grounds of Rejection.

Third Issue

Appellant argues that neither Ricci nor Ferguson et al., alone or in combination, teach or suggest the claim limitation "charging a fee based on a quantity of content served." The Appellant notes that independent claims 1, 9, 17, and 25-27, as well as claims 28 and 29, all recite "charging a fee based on a quantity of content served" or similar language. The Appellant

further recites "the quantity of content corresponds to the actual amount of data being served." As an example, the Applicant's Specification provides that "a sliding-fee scale.....,e.g. $30 for 1 gigabyte...." Examiner notes that the Appellant's specification actually recites "For example, a sliding-fee scale..." It is well established that *examples* in a specification do not further define a claim limitation, and therefore the Appellant's definition for the claim limitation "charging a fee based on a quantity of content served" is not based on the example given in the specification.

Recent decisions have indicated that if an inventor is relying on a special meaning for terms appearing in the claims, then the special meaning must be clearly written in the specification. "Although an applicant may be his own lexicographer... nothing in the specification defines the phrase 'quantity of content served' differently from its ordinary meaning", see *In Re Thrift*, 63 USPQ2d 2002, 2006 (Fed. Cir. 2002). "One purpose for examining the specification is to determine if the patentee has limited the scope of the claims.' ...For example, an inventor may choose to be his own lexicographer if he defines the specific terms used to describe the invention 'with reasonable clarity, deliberateness, and precision', see *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 63 USPQ2d 1374, 1381 (Fed. Cir. 2002) and *In re Paulsen*, 31 USPQ2d 1671, 1674-75 (Fed. Cir. 1994). Examiner submits that the "number of uses" disclosed by Ricci meets the definition for "quantity of content served" described by the Appellant.

Appellant argues, "the fee in Ricci is the copyright royalty payment". Examiner asserts that a fee owed to a copyright owner wherein the user is charged based on the number of uses (e.g. downloads, duration, etc.) is equivalent to the Appellant's "quantity of content." Further, the Appellant argues that "the amount of the fee charged is not linked to the number of uses in

the database." However, Examiner notes that a user purchasing a license to use the digital media would be charged based on the number of licenses that user purchases and therefore would be charged on the "quantity of content served." The Examiner notes the broadest reasonable interpretation of "number of uses" would include "quantity of content served." Further, Examiner notes during patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification," moreover the Examiner notes claims of issued patents are interpreted in light of the specification, but during examination, prosecution history, prior art, and other claims, must be interpreted as broadly as their terms reasonably allow (MPEP 2111). Thus, the Examiner interprets Ricci to disclose quantity of content served.

Examiner notes that Appellant's argument, "Different files will often be different sizes, and Ricci makes no differentiation between files of different size", is inconsistent with the Appellant's claim limitations. Appellant is attempting to read in a definition into the claim limitations which lacks support in the specification. Further, the claim limitations are broader than the definition that the Appellant is attempting to argue. Appellant's specification fails to define the claim limitation in a manner that one of ordinary skill in the art would read "quantity of content served" differently than the Examiner has already done.

Furthermore, Examiner notes that Ferguson et al. further teaches charging a user based on the quantity of content served. Ferguson et al. teaches, "The ability to set fees to be paid by the user *for an amount of data accessed*, the time spent "logged on" to the online service, or the purchase of particular merchandise..." Ferguson et al. thus teaches that it is old and well known in the art to charge a user based a quantity (i.e. amount) of content (data) served (accessed).

Fourth Issue

Appellant argues with respect to claims 3, 11, 19, 26, 27 and 29 that Ferguson et al. fails to teach paying owners of the affiliate servers a percentage of the fee charged for serving the content. However, Examiner notes that the Ferguson reference was cited for teaching charging or paying users or content providers (C. 9, lines 2-9). Ricci was cited for disclosing, "transfers of the digital media can be made on the bandwidth of the peers rather than the originator, ie. enabling client nodes to become affiliate servers that deliver content to other client nodes (0030). Ferguson et al.'s teaching of paying the content provider or user for the digital media transaction in combination with Ricci's disclosure of peer-to-peer file sharing teaches the Appellant's invention. Paying users who allow other client nodes to download files from their system is a basic economical decision wherein a resource supplier is reimbursed for their resource.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section **(9)** above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

Fadey S. Jabr
Examiner
Art Unit 3628

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

JOHN W. HAYES
SUPERVISORY PATENT EXAMINER

Conferees:

John W. Hayes

Vincent Millin

Electronic Acknowledgement Receipt

EFS ID:	2643137
Application Number:	09963812
International Application Number:	
Confirmation Number:	1207
Title of Invention:	DOCKETED MXH 12/27/07 Method and system for generating revenue in a peer-to-peer file delivery network
First Named Inventor/Applicant Name:	Jorg Gregor Schleicher
Customer Number:	27820
Filer:	Benjamin Withrow/Michelle Heymann
Filer Authorized By:	Benjamin Withrow
Attorney Docket Number:	1104-032
Receipt Date:	27-DEC-2007
Filing Date:	26-SEP-2001
Time Stamp:	11:37:41
Application Type:	Utility under 35 USC 111(a)

Payment information:

Submitted with Payment	no

File Listing:

Document Number	Document Description	File Name	File Size(Bytes) /Message Digest	Multi Part /.zip	Pages (if appl.)
1		Response_to_Examiner_Answer_mailed_10-30-07.pdf	394824 ea05bfac5c2e6be002543ca5145ae152854ec2a7	yes	6

	Multipart Description/PDF files in .zip description		
	Document Description	**Start**	**End**
	Amendment After Final	1	1
	Applicant Arguments/Remarks Made in an Amendment	2	6
Warnings:			
Information:			
	Total Files Size (in bytes):	394824	

This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

New Applications Under 35 U.S.C. 111
If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371
If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office
If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Jorg G. Schleicher et al.
Serial No. 09/963,812
Filed: 09/26/2001
For: **METHOD AND SYSTEM FOR GENERATING REVENUE IN A PEER-TO-PEER FILE DELIVERY NETWORK**

Examiner: Fadey S. Jabr
Art Unit: 3628

Mail Stop Amendment
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO THE EXAMINER'S ANSWER MAILED OCTOBER 30, 2007 UNDER 37 C.F.R. § 1.111

In response to the Examiner's Answer mailed October 30, 2007, the Applicants offer the following remarks under 37 C.F.R. § 1.111. If any additional fees are required in association with this response, the Director is hereby authorized to charge them to Deposit Account 50-1732, and consider this a petition therefor.

REMARKS

The Applicants have carefully reviewed the Examiner's Answer mailed October 30, 2007 and offer the following remarks.

The Applicants hereby request that prosecution be reopened before the Primary Examiner. Specifically, this response under 37 C.F.R. §1.111 addresses, and is relevant to, the new grounds of rejection issued in the Examiner's Answer mailed October 30, 2007. The Applicants submit that this request and response comply with 37 C.F.R. § 41.39(b)(1).

Claims 1-6, 9-14, 17-22, and 26-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ricci* in view of *Ferguson*. The Applicants respectfully traverse the rejection.

According to Chapter 2143.03 of the M.P.E.P., in order to "establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." The Applicants submit that neither *Ricci* nor *Ferguson*, either alone or in combination, discloses all the features recited in claims 1-6, 9-14, 17-22, and 26-29. More specifically, claim 1 recites a method for generating revenue in a peer-to-peer file delivery network comprising, among other features, "periodically sending the subscription-based content to each respective subscribing client node." Claim 17 includes similar features. The Applicants submit that none of the references, either alone or in combination, disclose periodically sending subscription-based content to a subscribing client node. In maintaining the rejection, the Patent Office asserts that *Ricci* discloses this feature at paragraph **[0040]**. (*See* Final Office Action mailed March 8, 2006, page 6). The Applicants respectfully disagree. At most, the cited portion of *Ricci* discloses that during the transfer of digital media, a network acts like a peer-to-peer network without requiring a central server. (*See Ricci*, paragraph **[0040]**). However, no mention is made of periodically sending subscription-based content to a subscribing client node. Furthermore, the Applicants have reviewed the remainder of the reference and submit that nowhere does *Ricci* disclose or suggest this feature. Likewise, the Applicants have reviewed *Ferguson* and submit that *Ferguson* does not disclose periodically sending subscription-based content to a subscribing client node.

Claim 1 also recites "charging a fee to providers of the subscription-based content for serving the subscription-based content." Claim 17 includes similar features. The Applicants submit that none of the references, either alone or in combination, disclose charging a fee to providers of the subscription-based content for serving the subscription-based content. As

correctly pointed out by the Patent Office, *Ricci* does not disclose this feature. (See Examiner's Answer mailed October 30, 2007, page 4). Similarly, *Ferguson* does not disclose this feature. Nevertheless, the Patent Office supports the rejection by stating that *Ferguson* discloses this feature at col. 4, ll. 53-60. (See Examiner's Answer mailed October 30, 2007, page 4). The Applicants respectfully disagree. While the cited portion of *Ferguson* does disclose levying fees against third party content owners for executing a transaction, *Ferguson* does not disclose charging a fee for subscription-based content. (See *Ferguson*, col. 4, ll. 53-60). Likewise, the Applicants have reviewed the remaining portions of *Ferguson* and submit that nowhere does the reference disclose this feature. Accordingly, for at least this reason, claims 1 and 17 are patentable over the cited references. Similarly, claims 2, 4-6, 18, and 20-22, which ultimately depend from claim 1 or 17, are patentable for at least the same reasons along with the novel features recited therein.

Claim 9 recites a system for generating revenue in a peer-to-peer file delivery network comprising, among other features, "means for enabling decentralized downloads of subscription-based content that client nodes of the multiple client nodes subscribe to in order to receive periodic updates." Claim 27 includes similar features. The Applicants respectfully submit that none of the references, either alone or in combination, disclose a means for enabling downloads of subscription-based content in order to receive periodic updates. As detailed above, none of the references, either alone or in combination, disclose periodically sending subscription-based content to a subscribing client node. Therefore, it follows that neither reference, either alone or in combination, can disclose receiving periodic updates nor a means for enabling downloads of subscription-based content in order to receive periodic updates.

Claim 9 also recites that "a fee is charged to providers of subscription-based content for serving the subscription-based content to the client nodes." Claim 27 includes similar features. As detailed above, none of the references, either alone or in combination, disclose charging a fee to providers of the subscription-based content for serving subscription-based content. As such, for this reason and the reason noted above, claims 9 and 27 are patentable over the cited references. Similarly, claims 10 and 12-14, which ultimately depend from claim 9, are patentable for at least the same reasons along with the novel features recited therein.

Claim 26 recites a method for generating revenue in a peer-to-peer file delivery network, comprising, among other features, "periodically sending the subscription-based content to each

respective subscribing client node." As detailed above, none of the references, either alone or in combination, disclose periodically sending subscription-based content to a subscribing client node. Claim 26 also recites "charging a fee to providers of the subscription-based content for serving the subscription-based content." As previously discussed, neither *Ricci* nor *Ferguson*, either alone or in combination, discloses charging a fee to providers of the subscription-based content for serving the subscription-based content.

Moreover, claim 26 recites enabling clients to become affiliate servers and paying affiliate server owners "a percentage of the fee charged for serving files." The Applicants submit that none of the cited references, either alone or in combination, disclose paying affiliate server owners a percentage of a fee charged for serving a file. As correctly pointed out by the Patent Office, *Ricci* does not disclose this feature. (See Examiner's Answer mailed October 30, 2007, page 6). Likewise, *Ferguson* does not disclose this feature. Nonetheless, the Patent Office supports the rejection by asserting that *Ferguson* discloses this feature at col. 15, ll. 7-11, col. 4, ll. 53-60, col. 14, ll. 30-31, and col. 9, ll. 2-9. (See Examiner's Answer mailed October 30, 2007, pages 6 and 7). The Applicants respectfully disagree. At most, the cited portions of *Ferguson* disclose levying fees against third party content owners for executing a transaction and that a server may charge or pay a user or a content provider a fee. (See *Ferguson*, col. 4, ll. 58-60 and col. 9, ll. 2-5; see also figure 2, step 240). However, nowhere do the cited portions, nor anywhere else in *Ferguson* for that matter, disclose paying an affiliate server owner a percentage of a fee charged for serving files. For this reason and the reasons noted above, claim 26 is patentable over the cited references and the Applicants request that the rejection be withdrawn.

Claim 3, which depends from claim 1, recites enabling clients to become affiliate servers and paying affiliate server owners "a percentage of the fee charged for serving files." Claim 11, which depends from claim 9, and claim 19, which depends from claim 17, include similar features. As detailed above, none of the cited references, either alone or in combination, disclose paying affiliate server owners a percentage of a fee charged for serving a file. For this reason and the reasons noted above with reference to claims 1, 9, and 17, claims 3, 11, and 19 are patentable over the cited references and the Applicants request that the rejection be withdrawn.

Claim 28 recites a system for generating revenue comprising, among other features, charging a fee "to providers of the subscription-based content for serving the subscription based content to the client nodes." As detailed above, none of the references, either alone or in

combination, disclose charging a fee to providers of the subscription-based content for serving subscription-based content. As such, claim 28 is patentable over the cited references and the Applicants request that the rejection be withdrawn.

Claim 29 recites a server node comprising, among other features, charging a fee "to providers of the subscription-based content for providing the subscription-based content to the client node." As mentioned above, neither *Ricci* nor *Ferguson*, either alone or in combination, discloses charging a fee to providers of the subscription-based content for serving subscription-based content. Claim 29 also recites that a client node may become an affiliate server such that an affiliate server owner "is paid a percentage of a fee charged for content delivery." As mentioned above, none of the references, either alone or in combination, disclose paying affiliate server owners a percentage of a fee charged for serving a file. For this reason and the reasons noted above, claim 29 is patentable over the cited references and the Applicants request that the rejection be withdrawn.

In addition, claims 7, 8, 15, 16, and 23-25 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Ricci* in view of *Ferguson* and further in view of the *Applicants' Related Art*. The Applicants respectfully traverse the rejection. Regarding claims 7, 8, 15, 16, 23, and 24, as detailed above, claims 1, 9, and 17, the base claims from which claims 7, 8, 15, 16, 23, and 24 ultimately depend, are patentable over *Ricci* and *Ferguson*. Moreover, the *Applicants' Related Art* does not overcome the previously noted shortcomings of both *Ricci* and *Ferguson*. Therefore, claims 7, 8, 15, 16, 23, and 24 are patentable over the cited references and the Applicants request that the rejection be withdrawn.

Claim 25 recites a method for providing subscription-based decentralized file downloads to client nodes in a peer-to-peer public network comprising, among other features, "periodically delivering the particular content files to respective clients nodes that subscribed to the particular content files." As detailed above, neither *Ricci* nor *Ferguson*, either alone or in combination, discloses periodically delivering content files to clients that subscribed to particular client files. In addition, the *Applicants' Related Art* does not disclose this feature. Accordingly, claim 25 is patentable over the cited references.

Claims 1-27 were also provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 16 and 17 of co-pending Application No. 08/814319 in view of *Ferguson*. The Applicants will address these rejections

when the Patent Office indicates that the claims in the present application include allowable subject matter. The Applicants reserve the right to file a terminal disclaimer, to distinguish the cited references, or to otherwise address the provisional obviousness-type double patenting rejections at a later time.

The present application is now in a condition for allowance and such action is respectfully requested. The Examiner is encouraged to contact the Applicants' representative regarding any remaining issues in an effort to expedite allowance and issuance of the present application.

Respectfully submitted,

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DOCKETED
MX H2/6/08

Office Action Summary	Application No.	Applicant(s)	
	09/963,812	SCHLEICHER ET AL.	
	Examiner	Art Unit	
	FADEY S. JABR	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 December 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-29* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-29* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

Claims 1-29 remain pending and are again presented for examination.

Response to Arguments

1. Due to the New Grounds of Rejection (specifically the rejection of claims 28-29) in the Examiner's Answer mailed 30 October 2007, the finality of Final Office action, mailed 8 March 2007 is withdrawn.

2. As stated by the applicant, claims **28-29** correspond to claims **9** and **27** but without the means plus function language. The claims were inadvertently not entered after the Non-final Office action mailed 7 October 2005. Therefore, Claims **28-29** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ricci, Pub. No. US2002/0062290 A1 in view of Ferguson et al., U.S. Patent No. 5,819,092.

3. Applicant argues that Ricci fails to disclose subscription services. Ricci discloses that collecting royalties without charging subscription fees is an alternative form of levying fees. Ricci actually discloses that the royalty may be a traditional charge (i.e. subscription fees or any other form of charging a user) (Para. 30). Examiner notes that Ricci does disclose charging a fee based on a quantity of content served, Ricci states that the royalties (fees) are based on the number of uses (quantity is equivalent to the number of uses) (Para. 53). Further, Ferguson et al. discloses paying owners of the affiliate servers. Content providers are affiliate server owners, where users can download content from the content provider node (Col. 9, lines 2-9).

4. Regarding the Applicant's argument that the Patent Office has failed to establish a *prima facie* case of obviousness, the Examiner asserts that the combination of references, i.e. Ricci in view of Ferguson et al., is proper. In this case, one of ordinary skill in the art would have been led to combine Ricci and Ferguson et al. in view of the fact that both references are directed to providing on-line content to users. Also, Ricci and Ferguson et al. are both related to charging users fees for downloading the content. For instance, Ricci discloses a method for distributing and licensing digital media across a network of peers (abstract). Ricci attempts to overcome the difficulties faced by content owners whose digital content was being downloaded in peer-to-peer networks without compensating the content owners by implementing a system that allows peer-to-peer file sharing while at the same time charging users for the content provided in order to compensate content owners. Ricci discloses users downloading a file will pay the appropriate royalty. Paying the appropriate royalty recoups the costs to the content provider for distributing the files, who must then compensate the content creator for use of their content. Furthermore, Ferguson et al. teaches a fee setting tool that allows the developer to develop a fee structure for an online service, e.g. downloading content (abstract). Ferguson et al. further teaches a third party content provider (i.e. content owner) can be paid when that third party content provider supplies valuable information desired by the users of the online services. The action of paying the content providers for supplying the information is in essence compensating the content providers for distributing the files. We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved. *In re Dembiczak*, 50 USPQ2d 1614. Therefore, the "motivation-suggestion-teaching" test asks not

merely what the references disclose, but whether a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in the prior art, and motivated by the general problem facing the inventor, would have been led to make the combination recited in the claims. *In re Kahn* 78 USPQ2d 1329 (CAFC 2006). Thus, someone of ordinary skill in the art would be led to combine Ricci and Ferguson et al.

5. Applicant argues that neither Ricci nor Ferguson et al., alone or in combination, teach or suggest the claim limitation "charging a fee based on a quantity of content served." The Applicant notes that independent claims 1, 9, 17, and 25-27, as well as claims 28 and 29, all recite "charging a fee based on a quantity of content served" or similar language. The Applicant further recites "the quantity of content corresponds to the actual amount of data being served." As an example, the Applicant's Specification provides that "a sliding-fee scale.....,e.g. $30 for 1 gigabyte...." Examiner notes that the Applicant's specification actually recites "For example, a sliding-fee scale..." It is well established that *examples* in a specification do not further define a claim limitation, and therefore the Applicant's definition for the claim limitation "charging a fee based on a quantity of content served" is not based on the example given in the specification.

Recent decisions have indicated that if an inventor is relying on a special meaning for terms appearing in the claims, then the special meaning must be clearly written in the specification. "Although an applicant may be his own lexicographer... nothing in the specification defines the phrase 'quantity of content served' differently from its ordinary meaning", see *In Re ThriftI,* 63 USPQ2d 2002, 2006 (Fed. Cir. 2002). "One purpose for examining the specification is to determine if the patentee has limited the scope of the claims.' ...For example, an inventor may choose to be his own lexicographer if he defines the specific

terms used to describe the invention 'with reasonable clarity, deliberateness, and precision', see *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 63 USPQ2d 1374, 1381 (Fed. Cir. 2002) and *In re Paulsen*, 31 USPQ2d 1671, 1674-75 (Fed. Cir. 1994). Examiner submits that the "number of uses" disclosed by Ricci meets the definition for "quantity of content served" described by the Applicant.

Applicant argues, "the fee in Ricci is the copyright royalty payment". Examiner asserts that a fee owed to a copyright owner wherein the user is charged based on the number of uses (e.g. downloads, duration, etc.) is equivalent to the Applicant's "quantity of content." Further, the Applicant argues that "the amount of the fee charged is not linked to the number of uses in the database." However, Examiner notes that a user purchasing a license to use the digital media would be charged based on the number of licenses that user purchases and therefore would be charged on the "quantity of content served." The Examiner notes the broadest reasonable interpretation of "number of uses" would include "quantity of content served." Further, Examiner notes during patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification," moreover the Examiner notes claims of issued patents are interpreted in light of the specification, but during examination, prosecution history, prior art, and other claims, must be interpreted as broadly as their terms reasonably allow (MPEP 2111). Thus, the Examiner interprets Ricci to disclose quantity of content served.

Examiner notes that Applicant's argument, "Different files will often be different sizes, and Ricci makes no differentiation between files of different size", is inconsistent with the Applicant's claim limitations. Applicant is attempting to read in a definition into the claim limitations which lacks support in the specification. Further, the claim limitations are broader

than the definition that the Applicant is attempting to argue. Applicant's specification fails to define the claim limitation in a manner that one of ordinary skill in the art would read "quantity of content served" differently than the Examiner has already done.

Furthermore, Examiner notes that Ferguson et al. further teaches charging a user based on the quantity of content served. Ferguson et al. teaches, "The ability to set fees to be paid by the user *for an amount of data accessed*, the time spent "logged on" to the online service, or the purchase of particular merchandise..." Ferguson et al. thus teaches that it is old and well known in the art to charge a user based a quantity (i.e. amount) of content (data) served (accessed).

6. Applicant argues with respect to claims 3, 11, 19, 26, 27 and 29 that Ferguson et al. fails to teach paying owners of the affiliate servers a percentage of the fee charged for serving the content. However, Examiner notes that the Ferguson reference was cited for teaching charging or paying users or content providers (C. 9, lines 2-9). Ricci was cited for disclosing, "transfers of the digital media can be made on the bandwidth of the peers rather than the originator, ie. enabling client nodes to become affiliate servers that deliver content to other client nodes (0030). Ferguson et al.'s teaching of paying the content provider or user for the digital media transaction in combination with Ricci's disclosure of peer-to-peer file sharing teaches the Applicant's invention. Paying users who allow other client nodes to download files from their system is a basic economical decision wherein a resource supplier is reimbursed for their resource

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims **1-6, 9-14, 17-22 and 26-29** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ricci, Pub. No. US2002/0062290 A1 in view of Ferguson et al., U.S. Patent No. 5,819,092.

As per **Claims 1, 9, 17 and 29**, Ricci discloses a method for generating revenue in a peer-to-peer file delivery network, the network including at least one server node and multiple client nodes, the method comprising the steps of:

(a) enabling peer-to-peer file sharing of content by,

- (i) initiating on one client node a download of a particular content item served from the server node or another client node (0030-0033), and
- (ii) charging a fee based on a quantity of the content served (0022, 0053); and

(b) enabling decentralized downloads of subscription-based content by

- (i) allowing the client nodes to subscribe to one or more of the subscription-based content (0057, 0061),
- (ii) periodically sending the subscribed to subscription-based content to each the respective subscribing client nodes (0040).

Nonetheless, Ricci fails to disclose charging a fee to providers of the subscription-based content for serving the subscription-based content. However, Ferguson et al. teaches levying fees on content providers for transactions with the users (C. 4, lines 53-60). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Ricci and charge a fee to subscription-based content providers for transmitting their content as taught by Ferguson et al. because charging users and content providers a fee would greatly increase profitability of the file sharing service.

As per **Claims 2, 10, 18**, Ricci further discloses a method of providing direct marketing by sending marketing content to the client nodes from the server node as well as from other client nodes (0065, lines 1-8). Ricci fails to disclose charging a fee to providers of the marketing content. However, Ferguson et al. teaches charging a fee to providers of the marketing content (C. 14, lines 30-31). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Ricci to include charging marketing content providers a fee as taught by Ferguson et al. because charging marketing content providers a fee would greatly increase profitability of the file sharing service.

As per **Claims 3, 11, and 19**, Ricci further discloses a method enabling client nodes to become affiliate servers that deliver content to other client nodes (0030). Ricci fails to disclose paying owners of the affiliate servers a percentage of the fee charged for serving the files. However, Ferguson et al. teaches paying the user of the service (C. 9, lines 2-9). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to

modify the method of Ricci to include paying users of the affiliate servers a portion of the fee charged for serving the files as taught by Ferguson et al. because paying owners of the affiliate servers would increase retention of the affiliate server owners.

As per **Claims 4-6, 12-14, and 20-22**, Ricci further discloses a method including the steps of charging a fee from a user of the initiating client node for the download of the fee-based content (0022, 0053). Ricci fails to disclose charging a fee from a provider of the free content for serving the free content. However, Ferguson et al. teaches charging content providers a fee (C. 4, lines 53-60). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Ricci to include charging content providers a fee for serving the free content as taught by Ferguson et al. because charging content providers a fee would greatly increase profitability of the file sharing service.

As per **Claims 26-28**, Ricci discloses a system for generating revenue in a peer-to-peer file delivery network, the network including at least one server node and multiple client nodes, the method comprising the steps of:

- means for enabling peer-to-peer file sharing of content whereby one client node initiates a download of a particular content item served from the server node or another client node (0018), and
- wherein a fee is charged based on a quantity of the content served (0022, 0053);

- means for providing direct marketing to client nodes such that marketing content is send to the client nodes from the server node as well as from other client nodes (0065, lines 1-8),
- means for enabling client nodes to become affiliate servers that deliver content to other client nodes (0030),

Nonetheless, Ricci fails to disclose:

- means for enabling decentralized downloads of subscription-based content that the client nodes subscribe to in order to receive periodic updates, wherein a fee is charged to providers of the subscription-based content for serving the subscription-based content to the client nodes;
- owners of the affiliate servers are paid a percentage of the fee charged for serving the files.
- a fee is charged to providers of the marketing content.

However, Ferguson et al. teaches users of the system receive periodic updates; levying fees on content providers for transactions with the users; paying users of affiliate servers for serving the files, and finally teaches charging marketing content providers a fee (C. 15, lines 7-11; C. 4, lines 53-60; C. 14, lines 30-31; C. 9, lines 2-9). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Ricci and include providing periodic updates to users, levying fees on content providers, and to pay owners of affiliate servers for serving the files as taught by Ferguson et al. because charging content providers a fee would greatly increase profitability of the file sharing service. Also, paying

owners of affiliate servers because paying owners of the affiliate servers would increase retention of the affiliate server owners.

9. Claims 7, 8, 15, 16, 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ricci, Pub. No. US2002/0062290 A1 in view of Ferguson et al., U.S. Patent No. 5,819,092 as applied to claims **1, 9, 17 and 29** above, and further in view of Applicants admission of the prior art.

As per **Claims 7, 15, and 23**, Ricci fails to disclose a method of charging a fee from the provider of the marketing content based on a cost per click. However, Applicant discloses that this feature is old and well known, see Specification, Page 11, lines 8-11. Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the Ricci and include charging a fee from the marketing content provider based on a cost per click as disclosed by Applicant. By Applicant's own admission, the feature of charging a fee from the provider of the marketing content based on a cost per click is admitted prior art.

As per **Claims 8, 16, and 24**, Ricci fails to disclose a method of charging a fee from the provider of the marketing content based on a cost per acquisition. However, Applicant discloses that this feature is old and well known, see Specification, Page 11, lines 8-11. Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the Ricci and include charging a fee from the marketing content provider based on a cost per acquisition as disclosed by Applicant. By Applicant's own admission, the feature of

charging a fee from the provider of the marketing content based on a cost per acquisition is admitted prior art.

As per **Claim 25**, Ricci fails to disclose a method for providing subscription-based decentralized file downloads to client nodes in a peer-to-peer public network, each of the client nodes affiliated with a user account, the method comprising the steps of:

- (b) allowing the client nodes to subscribe to one or more of the content files (0057, 0061);
- (c) periodically delivering the particular content files to the respective clients nodes that subscribed to the content files (0040);
- (f) charging the user accounts of the client nodes that received fee-based subscription content files (0022, 0053).

Nonetheless, Ricci fails to disclose:

- (a) receiving content files from at least one content provider, the content including free subscription content files, fee-based subscription content files, and marketing content files;
- (d) charging the content provider a fee for delivering the content files to the client nodes over the network.

However, Ferguson et al. teaches receiving content files from content providers; and also charging content providers a fee for serving the content files to the users (C. 4, lines 53-60). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Ricci and include receiving content files from content

providers and charging content providers a fee for serving the files as taught by Ferguson et al. because charging a variety of content providers a fee would greatly increase profitability of the file sharing service. Ricci and Ferguson et al. nonetheless fail to disclose charging the content provider a fee for the marketing content files based on a number of users that access the marketing content files once downloaded. However, Applicant discloses that this feature is old and well known, see Specification, Page 11, lines 8-11. Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the Ricci and include charging content provider a fee based on the number of users to access the content as disclosed by Applicant. By Applicant's own admission, the feature of charging a fee from the provider of the marketing content based on a cost per acquisition is admitted prior art.

Double Patenting

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1-27 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims **16 and 17** of copending Application No. 09/814319 in view of Ferguson et al., U.S. Patent No. 5,819,092.

This is a provisional obviousness-type double patenting rejection.

Although the conflicting claims are not identical, they are not patentably distinct from each other. Claims **16 and 17** of Application No. 09/814319 recite:

A peer-to-peer file delivery network, comprising:

- at least one server node;
- multiple client nodes coupled to the server node over the network, each of the client nodes running a client application, wherein the client application works and operates in conjunction with the server node to enable secure and reliable peer-to-peer file sharing between two client nodes by,

enable secure and reliable peer-to-peer file sharing between two client nodes by,

- generating account information for a user of each client node, including a digital certificate, in response to a registration process, wherein the digital certificate includes a private key and a public key,
- in response to a file being selected for publication on a first client node by a first user,

- generating and associating a digital fingerprint with the file,

- generating a bitstream ID for the file and including the bitstream ID in the fingerprint, and

- using the user's private key to generate a digital signature from the

file and including the digital signature in the fingerprint,

adding an entry for the file to a search list of shared files on the server

- node and storing the fingerprint on the server,

- in response to a second client node selecting the file from the search list on the server node, automatically transferring the file from the first client node directly to the second client node, and

- authenticating the file by the second client node by generating a new bitstream ID, comparing the new bitstream ID to the bitstream ID in the fingerprint stored on the server, and using the user's public key to decrypt the digital signature to determine the authenticity and reliability of the file and publisher.

The network of claim 17 wherein the client application operates in conjunction with the server node to enable subscription-based decentralized file downloads to the client nodes by

- allowing the client nodes to subscribe with the server node to periodically receive copies of one of the files,
- when providing a current subscribing client node with the file, locating the closest client node containing the file, and
- transferring the file from the closest node directly to the current subscribing node, thereby efficiently utilizing bandwidth.

Claims 16 and 17 of Application No. 09/814319 differs since it further recites additional claim limitations including generating account information for a user of each client node, including a digital certificate; authenticating the file by the second client node by generating a new bitstream

ID; and allowing client nodes to subscribe with the server node to periodically receive copies of one of the files. However, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify claims **16 and 17** of Application No. 09/814319 by removing the limitations directed to generating account information, authenticating a file using a bitstream, and allowing client nodes to subscribe with the server node resulting generally in the claims of the present application since the claims of the present application and the claims recited in Application No. 09/814319 actually perform a similar function. It is well established that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before.

Also, claims **16 and 17** of Application No. 09/814319 differ since they fail to recite a method for charging a fee to providers and users of the subscription-based content, either for serving the subscription-based content to the users or for receiving the content. Ferguson et al. teaches a method for levying fees against both users and content providers in an online system (C. 4, lines 53-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify claims **16 and 17** of Application No. 09/814319 and include the method of charging a fee to providers and users of the subscription-based content as taught by Ferguson et al. because charging users and content providers a fee would greatly increase profitability for the service.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FADEY S. JABR whose telephone number is (571)272-1516. The examiner can normally be reached on Mon. - Fri. 8:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Fadey S Jabr
Examiner
Art Unit 3628

FSJ

Please address mail to be delivered by the United States Postal Service (USPS) as follows:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(571) 273-1516 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314

/F. S. J./
Examiner, Art Unit 3628

/JOHN W HAYES/
Supervisory Patent Examiner, Art Unit 3628

Electronic Acknowledgement Receipt

EFS ID:	3096934
Application Number:	09963812
International Application Number:	
Confirmation Number:	1207
Title of Invention:	DOCKETED MKH 4/3/08 Method and system for generating revenue in a peer-to-peer file delivery network
First Named Inventor/Applicant Name:	Jorg Gregor Schleicher
Customer Number:	27820
Filer:	Benjamin Withrow/Michelle Heymann
Filer Authorized By:	Benjamin Withrow
Attorney Docket Number:	1104-032
Receipt Date:	03-APR-2008
Filing Date:	26-SEP-2001
Time Stamp:	11:20:39
Application Type:	Utility under 35 USC 111(a)

Payment information:

Submitted with Payment	no

File Listing:

Document Number	Document Description	File Name	File Size(Bytes) /Message Digest	Multi Part /.zip	Pages (If appl.)
1		Response_to_OAF_mailed_2-4-08.pdf	432113 2badb3af0829f13f44ab4a2d2d8a077ab04f805b	yes	6

	Multipart Description/PDF files in .zip Description		
	Document Description	Start	End
	Amendment After Final	1	1
	Applicant Arguments/Remarks Made in an Amendment	2	6

Warnings:	
Information:	
Total Files Size (in bytes):	432113

This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

New Applications Under 35 U.S.C. 111

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Jorg G. Schleicher et al.
Serial No. 09/963,812
Filed: 09/26/2001
Examiner: Fadey S. Jabr
Art Unit: 3628
For: **METHOD AND SYSTEM FOR GENERATING REVENUE IN A PEER-TO-PEER FILE DELIVERY NETWORK**

Mail Stop AF
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO THE FINAL OFFICE ACTION MAILED FEBRUARY 4, 2008

In response to the Final Office Action mailed February 4, 2008, the Applicants offer the following remarks. If any fees are required in association with this response, the Director is hereby authorized to charge them to Deposit Account 50-1732, and consider this a petition therefor.

REMARKS

The Applicants have carefully reviewed the Final Office Action mailed February 4, 2008 (hereinafter "Final Office Action") and offer the following remarks.

Claims 1-6, 9-14, 17-22, and 26-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0062290 A1 to *Ricci* (hereinafter "*Ricci*") in view of U.S. Patent No. 5,819,092 to *Ferguson et al.* (hereinafter "*Ferguson*"). The Applicants respectfully traverse the rejection.

According to Chapter 2143.03 of the M.P.E.P., in order to "establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." The Applicants submit that neither *Ricci* nor *Ferguson*, either alone or in combination, discloses all the features recited in claims 1-6, 9-14, 17-22, and 26-29. More specifically, claim 1 recites a method for generating revenue in a peer-to-peer file delivery network comprising, among other features, "periodically sending the subscription-based content to each respective subscribing client node." Claim 17 includes similar features. The Applicants submit that none of the references, either alone or in combination, disclose periodically sending subscription-based content to a subscribing client node. In maintaining the rejection, the Patent Office asserts that *Ricci* discloses this feature in paragraph **[0040]**. (*See* Final Office Action, page 6). The Applicants respectfully disagree. At most, the cited portion of *Ricci* discloses that during the transfer of digital media, a network acts like a peer-to-peer network without requiring a central server. (*See Ricci*, paragraph **[0040]**). However, no mention is made of periodically sending subscription-based content to a subscribing client node. Furthermore, the Applicants have reviewed the remainder of the reference and submit that nowhere does *Ricci* disclose this feature. Likewise, the Applicants have reviewed *Ferguson* and submit that *Ferguson* does not disclose periodically sending subscription-based content to a subscribing client node.

The Patent Office addresses this rejection by asserting that *Ricci* discloses subscription services. In particular, the Patent Office indicates that *Ricci* discloses collecting royalties without charging subscription fees and those royalties may be traditional charges, such as a subscription fee, as disclosed in paragraph **[0030]** of *Ricci*. (See Final Office Action, page 2). The Patent Office goes on to state that *Ricci* discloses that royalties are based on a number of uses where a quantity is equivalent to the number of uses, as disclosed in paragraph **[0053]** of *Ricci*. (See Final Office Action, page 2). Regarding the disclosure in paragraph **[0030]** of *Ricci*,

the Applicants respectfully disagree. The Applicants are not arguing that *Ricci* does not disclose subscription services. Instead, the Applicants are arguing that *Ricci* does not disclose periodically sending subscription-based content, which, as previoudly discussed, Ricci does not disclose.

Regarding the disclosure in paragraph **[0053]** of *Ricci*, the Applicants respectfully submit that the disclosure in this paragraph is not available as prior art against the present application. More specifically, the present application has a filing date of September 26, 2001, well before the filing date of *Ricci*, which is December 18, 2001. *Ricci* claims the benefit of provisional application no. 60/252,334 having a filing date of November 22, 2000. Nonetheless, the subject matter of paragraph **[0053]** is not disclosed in the provisional application. Therefore, this subject matter is not available as prior art against the present application.

In addressing the argument that none of the references disclose the feature of periodically sending subscription-based content to a subscribing client node, the Patent Office also asserts that *Ferguson* discloses this feature in col. 9, ll. 2-9. (See Final Office Action, page 2). The Applicants respectfully disagree. While the cited portion of *Ferguson* does disclose an online service, which may charge or pay a user of a content provider, nowhere does the cited portion disclose periodically sending subscription-based content to a subscribing client node. (See *Ferguson*, col. 9, ll. 4-5). Thus, the Applicants submit that claims 1 and 17 are patentable over the cited references. Similarly, claims 2, 4-6, 18, and 20-22, which ultimately depend from claim 1 or 17, are patentable for at least the same reasons along with the novel features recited therein.

Claim 9 recites a system for generating revenue in a peer-to-peer file delivery network comprising, among other features, "means for enabling decentralized downloads of subscription-based content that client nodes of the multiple client nodes subscribe to in order to receive periodic updates." Claim 27 includes similar features. The Applicants respectfully submit that none of the references, either alone or in combination, disclose a means for enabling downloads of subscription-based content in order to receive periodic updates. As detailed above, none of the references, either alone or in combination, disclose periodically sending subscription-based content to a subscribing client node. Therefore, it follows that neither reference, either alone or in combination, can disclose receiving periodic updates nor a means for enabling downloads of subscription-based content in order to receive periodic updates. As such, claims 9 and 27 are

patentable over the cited references. Similarly, claims 10 and 12-14, which ultimately depend from claim 9, are patentable for at least the same reasons along with the novel features recited therein.

Claim 26 recites a method for generating revenue in a peer-to-peer file delivery network, comprising, among other features, "periodically sending the subscription-based content to each respective subscribing client node." As detailed above, none of the references, either alone or in combination, disclose periodically sending subscription-based content to a subscribing client node.

Moreover, claim 26 recites enabling clients to become affiliate servers and paying affiliate server owners "a percentage of the fee charged for serving files." The Applicants submit that none of the cited references, either alone or in combination, disclose paying affiliate server owners a percentage of a fee charged for serving a file. As correctly pointed out by the Patent Office, *Ricci* does not disclose this feature. (See Examiner's Answer mailed October 30, 2007, page 6). Likewise, *Ferguson* does not disclose this feature. Nonetheless, the Patent Office supports the rejection by asserting that *Ferguson* discloses this feature in col. 15, ll. 7-11, col. 4, ll. 53-60, col. 14, ll. 30-31, and col. 9, ll. 2-9. (See Examiner's Answer mailed October 30, 2007, pages 6 and 7). The Applicants respectfully disagree. At most, the cited portions of *Ferguson* disclose levying fees against third party content owners for executing a transaction and that a server may charge or pay a user or a content provider a fee. (See *Ferguson*, col. 4, ll. 58-60 and col. 9, ll. 2-5; see also Figure 2, step 240). However, nowhere do the cited portions, nor anywhere else in *Ferguson* for that matter, disclose paying an affiliate server owner a percentage of a fee charged for serving files.

The Patent Office addresses this argument by stating that in *Ferguson* the teaching of paying a content provider or user for a digital media transaction in combination with the disclosure in *Ricci* relating to peer-to-peer file sharing discloses the feature of paying affiliate server owners a percentage of a fee charged for serving a file. (See Final Office Action, page 6). Moreover, the Patent Office asserts that allowing other client nodes to download files from their system is a basic economical decision wherein a resource supplier is reimbursed for their resource. (See Final Office Action, page 6). The Applicants fails to recognize how combining the teaching of paying a content provider or a user for digital media transaction with the teaching of peer-to-peer file sharing discloses paying affiliate server owners a <u>percentage</u> of a fee charged

for serving a file. Even assuming, *arguendo*, that allowing other client nodes to download files from their system is a basic economical decision wherein a resource supplier is reimbursed for their resource, nowhere does either reference, either in the cited portion or anywhere else, disclose anything about percentages, much less paying affiliate server owners a percentage of a fee charged for serving a file. For this reason and the reasons noted above, claim 26 is patentable over the cited references and the Applicants request that the rejection be withdrawn.

Claim 3, which depends from claim 1, recites enabling clients to become affiliate servers and paying affiliate server owners "a percentage of the fee charged for serving files." Claim 11, which depends from claim 9, and claim 19, which depends from claim 17, include similar features. As detailed above, none of the cited references, either alone or in combination, disclose paying affiliate server owners a percentage of a fee charged for serving a file. For this reason and the reasons noted above with reference to claims 1, 9, and 17, claims 3, 11, and 19 are patentable over the cited references and the Applicants request that the rejection be withdrawn.

Claim 28 recites a system for generating revenue in a peer-to-peer file delivery network comprising, among other features, charging a fee based on a quantity of content served when a client downloads contents and then charging a second fee to providers of subscription-based content when subscription-based content is served to client nodes. The Applicants have reviewed both *Ricci* and *Ferguson* and submit that neither of the references, either alone or in combination, discloses charging a fee based on a quantity of content served when a client downloads content and then charging a second fee to providers of subscription-based content when subscription-based content is served to client nodes. Accordingly, claim 28 is patentable over the cited references and the Applicants request that the rejection be withdrawn.

Claim 29 also recites that a client node may become an affiliate server such that an affiliate server owner "is paid a percentage of a fee charged for content delivery." As mentioned above, none of the references, either alone or in combination, disclose paying affiliate server owners a percentage of a fee charged for serving a file. For at least this reason, claim 29 is patentable over the cited references and the Applicants request that the rejection be withdrawn.

In addition, claims 7, 8, 15, 16, and 23-25 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Ricci* in view of *Ferguson* and further in view of the *Applicants' Related Art*. The Applicants respectfully traverse the rejection. Regarding claims 7, 8, 15, 16, 23, and 24, as detailed above, claims 1, 9, and 17, the base claims from which claims 7, 8, 15, 16, 23, and 24

ultimately depend, are patentable over *Ricci* and *Ferguson*. Moreover, the *Applicants' Related Art* does not overcome the previously noted shortcomings of both *Ricci* and *Ferguson*. Therefore, claims 7, 8, 15, 16, 23, and 24 are patentable over the cited references and the Applicants request that the rejection be withdrawn.

Claim 25 recites a method for providing subscription-based decentralized file downloads to client nodes in a peer-to-peer public network comprising, among other features, "periodically delivering the particular content files to respective clients nodes that subscribed to the particular content files." As detailed above, neither *Ricci* nor *Ferguson*, either alone or in combination, discloses periodically delivering content files to clients that subscribed to particular client files. In addition, the *Applicants' Related Art* does not disclose this feature. Accordingly, claim 25 is patentable over the cited references.

Claims 1-27 were also provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 16 and 17 of co-pending Application No. 08/814,319 in view of *Ferguson*. The Applicants will address these rejections when the Patent Office indicates that the claims in the present application include allowable subject matter. The Applicants reserve the right to file a terminal disclaimer, to distinguish the cited references, or to otherwise address the provisional obviousness-type double patenting rejection at a later time.

The present application is now in a condition for allowance and such action is respectfully requested. The Examiner is encouraged to contact the Applicants' representative regarding any remaining issues in an effort to expedite allowance and issuance of the present application.

Respectfully submitted,

WITHROW & TERRANOVA, P.L.L.C.

By: 

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Date: April 3, 2008
Attorney Docket: 1104-032

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,812	09/26/2001	Jorg Gregor Schleicher	1104-032	1207

27820 7590 04/29/2008

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EXAMINER	
JABR, FADEY S	

ART UNIT	PAPER NUMBER
3628	

MAIL DATE	DELIVERY MODE
04/29/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DOCKETED
MFA 5/5/08

Advisory Action Before the Filing of an Appeal Brief	Application No. 09/963,812	Applicant(s) SCHLEICHER ET AL	
	Examiner FADEY S. JABR	Art Unit 3628	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 April 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
   b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: 1-29.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☒ Other: See Continuation Sheet.

/JOHN W HAYES/
Supervisory Patent Examiner, Art Unit 3628

Continuation of 13. Other: Examiner notes that periodically sending subscription based content taken in the broadest reasonable interpretation is a content being transferred to users. Ricci discloses transferring content to users (0040). Page 8 pf the provisional application 60/252334 discloses file owners or entities that share fulles to program the files to report royalties for advertising fees, report number of downloads vs actual opening of files, reports overall usage of a file's life span. Further, on page 8, Ricci discloses tracking and licensing of files. Also, on page 8, Ricci discloses track all end user destinations for determination of royalty payments. On Page 9, Ricci discloses The software trigger or digital acknowledgement trigger is sent to the servers which originate the file download or transfer, an advertising company is matched to the MPS on route to the user....The invention induced the software trigger...will send the commercials out based on the tag received to the end user simultaneously with the MP3 download (pp. 9-10). Therefore, the provisional application does qualify as prior art.

Further, Applicant argues that there is no suggesion to combine the references. Examiner asserts that Ricci and Ferguson et al. are both directed to charging and delivery of on-line content. Further, the combination of Ricci, Ferguson and Applicant's admission of the prior art is valid. One of ordinary skill would be led to combine the references seeing as they all are directed to charging for content. Applicant also argues that Ricci does not teach or suggest monitoring the quantity of the content served. Examiner asserts that tracking which recipients have licensed which digital media is equivalent to monitoring the quantity of the content served. Examiner asserts that charging based on the number of uses is equivalent to charging based on the quantity of content served. In both cases an amount of content is delivered to a user, and in both cases the user is charged based on the amount of content that is delivered to the user. As taken in its broadest reasonable interpretation, "quantity" is believed to be equivalent to the number of uses. .

claim 28

claim 28
↓
still hasn't established charging 2nd fee to providers of subscription-based content

mentions nothing about it being subscription based

Electronic Acknowledgement Receipt

EFS ID:	3294256
Application Number:	09963812
International Application Number:	
Confirmation Number:	1207
Title of Invention:	DOCKETED MCH 5/13/08 Method and system for generating revenue in a peer-to-peer file delivery network
First Named Inventor/Applicant Name:	Jorg Gregor Schleicher
Customer Number:	27820
Filer:	Benjamin Withrow/Michelle Heymann
Filer Authorized By:	Benjamin Withrow
Attorney Docket Number:	1104-032
Receipt Date:	13-MAY-2008
Filing Date:	26-SEP-2001
Time Stamp:	11:33:37
Application Type:	Utility under 35 USC 111(a)

Payment information:

Submitted with Payment	no

File Listing:

Document Number	Document Description	File Name	File Size(Bytes) /Message Digest	Multi Part /.zip	Pages (if appl.)
1	Miscellaneous Incoming Letter	Statement_for_Discounted_Notice_of_Appeal.pdf	80640 0c94723d00be080537e3a5f750d45c91e72194ba	no	2

Warnings:	
Information:	

2	Notice of Appeal Filed	Notice_of_Appeal_5-13-08.pdf	72986 dd17ea53ed76778bbff8d141eb235700a3ae1f1	no	1
Warnings:					
Information:					
			Total Files Size (in bytes):	153626	

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New Applications Under 35 U.S.C. 111

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Jorg G. Schleicher et al.
Serial No. 09/963,812
Filed: 09/26/2001
Examiner: Fadey S. Jabr
Art Unit: 3628
For: **METHOD AND SYSTEM FOR GENERATING REVENUE IN A PEER-TO-PEER FILE DELIVERY NETWORK**

Mail Stop AF
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

STATEMENT FOR DISCOUNTED NOTICE OF APPEAL

A Notice of Appeal is being filed concurrently with this statement. The Applicants previously filed a Notice of Appeal on July 7, 2006 and an Appeal Brief on December 6, 2006. The Applicants paid the $500.00 fee associated with the Notice of Appeal and the Appeal Brief when each was filed.

In response to the Appeal Brief, an Examiner's Answer was mailed on February 27, 2007 and a Reply Brief was filed on April 24, 2007. The Appeal Brief was undocketed on October 5, 2007 in order for the Examiner to correct the Examiner's Answer mailed on February 27, 2007. A Supplemental Examiner's Answer was mailed on October 30, 2007 and a Response to the Examiner's Answer was filed on December 27, 2007. Prosecution was then reopened through the mailing of a final office action on February 4, 2008. As such, the Appeal Brief filed on December 6, 2006 was not reviewed by the Board of Patent Appeals and Interferences and no decision was rendered in response to the Appeal Brief. The Applicants have continued prosecution and concurrently file a new Notice of Appeal.

The Applicants should not have to pay the full amount of $510.00 for this Notice of Appeal because the Notice of Appeal filed on July 7, 2006 and the Appeal Brief filed on December 6, 2006 had been paid for and no decision had been rendered. See M.P.E.P § 1207.04. The Applicants note that the fee for a Notice of Appeal increased by $10.00. As such, only the $10.00 fee is due for the current Notice of Appeal. The Director is hereby authorized to charge the $10.00 Notice of Appeal fee to Deposit Account 50-1732, and to consider this a petition therefor. If any additional fees are required in association with this Notice of Appeal, the

Director is hereby authorized to charge them to Deposit Account 50-1732, and consider this a petition therefor.

Respectfully submitted,

WITHROW & TERRANOVA, P.L.L.C.

By: 

Anthony J. Josephson
Registration No. 45,742
100 Regency Forest Drive, Suite 160
Cary, NC 27518
Telephone: (919) 238-2300

Date: May 13, 2008
Attorney Docket: 1104-032

PTO/SB/31 (08-03)
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NOTICE OF APPEAL FROM THE EXAMINER TO THE BOARD OF PATENT APPEALS AND INTEFERENCES

Docket Number (Optional): 1104-032

I hereby certify that this correspondence is being transmitted via facsimile on the date indicated below to:
Examiner: _____
Fax Number: _____ Art Unit: _____
Date:

Signature _____

Typed or printed name _____

In re Application of: Jorg G. Schleicher et al.

Application Number	Filed
09/983,812	9/26/2001

For: METHOD AND SYSTEM FOR GENERATING REVENUE IN A PEER-TO-PEER FILE DELIVERY NETWORK

Art Unit	Examiner
3628	Fadey S. Jabr

Applicant hereby appeals to the Board of Patent Appeals and Interferences from the last decision of the examiner.

The fee for this Notice of Appeal is (37 CFR 1.17(b)) $ 10.00

☐ Applicant claims small entity status. See 37 CFR 1.27. Therefore, the fee shown above is reduced by half, and the resulting fee is: $ _____

☐ A check in the amount of the fee is enclosed.

☐ Payment by credit card. Form PTO-2038 is attached.

☐ The Director has already been authorized to charge fees in this application to a Deposit Account. I have enclosed a duplicate copy of this sheet.

☑ The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. 50-1732. I have enclosed a duplicate copy of this sheet.

☐ A petition for an extension of time under 37 CFR 1.136(a) (PTO/SB/22) is enclosed.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

☑ attorney or agent of record. Registration number 45,742.

☐ attorney or agent acting under 37 CFR 1.34(a). Registration number if acting under 37 CFR 1.34(a). _____

Signature

Anthony J. Josephson
Typed or printed name

919-238-2300
Telephone number

May 13, 2008
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 37 CFR 1.191. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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